TRANSCRIPT OF RECORD.

SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1900.

No. 290.

CHARLES M. HIGGINS AND JOHN GIANELLA,
APPELLANTS,

vs.

WILLIAM D. KEUFFEL AND HERMAN ESSER.

APPEAL FROM THE CIRCUIT COURT OF THE UNITED STATES FOR
THE SOUTHERN DISTRICT OF NEW YORK.

FILED OCTOBER 31, 1900.

which this is a supplement shall hereafter be issued; and every certificate heretofore issued in pursuance thereof, is hereby declared void and of no effect, and the Chinese laborer claiming admission by virtue thereof shall not be permitted to enter the United States.

SEC. 3. That all the duties prescribed, liabilities, penalties, and forfeitures imposed, and the powers conferred by the second, tenth, eleventh, and twelfth sections of the act to which this is a supplement are hereby extended and made applicable to the provisions of this act.

SEC. 4. That all such part or parts of the act to which this is a supplement as are inconsistent herewith are hereby repealed.

Approved October 1, 1888.

If Wan Shing was ever in the United States previous to August 7, 1889, he came in 1878 or in 1880. His testimony on the trial asserts the latter date. He alleges that he went back to China April 19, 1882, and that he came back here in 1889, reaching San Francisco August 7 of that year.

It is manifest that the exclusion of Wan Shing from the United States under this statute, as established and construed by this court in the decision of *The Chinese Exclusion Case* (130 U. S., 581), is distinct and absolute.

It is respectfully submitted that the order and judgment of remand should be affirmed.

A. X. PARKER,
Assistant Attorney-General.

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INDEX.

	Original.	Print
Subpœna	1	1
Marshal's return	2	1
Bill of complaint	3	1
Appearance for defendants	9	5
Answer	10	5
Replication	16	9
Evidence for complainants	17	10
Testimony of Chas. M. Higgins	18	10
John E. Gavin	46	26
George S. Woolman	48	28
Exhibit No. 2—Letter of Commissioner of Patents to Chas. M. Higgins, November 1, 1883	51	29
No. 3—Certificate of registration of label No. 3693, November 20, 1883, and copy of label attached	52	30
No. 1—Copy of label	53	30
Wrapper—Copy of wrapper	53	30
Box—Copy of label on box for shipping	53	30
No. 4—Infringing label from exhibit	54	30
No. 5—Copy of label	54	36
No. 9—Labels of defendants	55	30
No. 6—Letter of Keuffel & Esser to Charles M. Higgins, March 6, 1884	57	31
No. 11—Assignment of Charles M. Higgins to Chas. M. Higgins & Co., February 11, 1886	57	31

JUDD & DETWEILER, PRINTERS, WASHINGTON, D. C., SEPTEMBER 12, 1890.

	Original.	Print.
Minutes of argument	57½	31
Opinion	58	31
Final decree	63	33
Petition of appeal	65	33
Allowance of appeal	68	35
Bond on appeal	69	35
Citation (copy)	71	36
Stipulation as to record on appeal	73	36
Clerk's certificate	74	37

1 [L. S.] The President of the United States of America to William D. Keuffel and Hermann Esser, Greeting:

You are hereby commanded that you and each of you personally appear before the judges of the circuit court of the United States of America for the southern district of New York, in the second circuit court, in equity, on the first Monday of July, A. D. 1886, wherever the said court shall then be, to answer a bill of complaint exhibited against you in the said court by Charles M. Higgins and John Gianella, and do further and receive what the said court shall have considered in that behalf; and this you are not to omit under the penalty on you and each of you of two hundred and fifty dollars.

Witness Honorable Morrison R. Waite, Chief Justice of the Supreme Court of the United States, at the city of New York, on the twelfth day of June, in the year one thousand eight hundred and eighty-seven, and of the Independence of the United States of America the one hundred and tenth.

TIMOTHY GRIFFITH, *Clerk.*

THOMAS J. KEIGHARN,
Complainants' Sol'r.

The defendants are required to enter appearance in the above cause in the clerk's office of this court on or before the first Monday of July, 1886, or the bill will be taken *pro confesso* against them.

T. G., *Clerk.*

2 (Endorsed:) I hereby certify that on the 12th day of June, 1886, at the city of New York, in my district, I personally served the within subpœna upon the within-named Hermann Esser by exhibiting to Hermann Esser the within original and at the same time leaving with him a copy thereof. Dated June 12th, 1886. (S'g'd) Martin T. McMahon, United States marshal, southern district of New York. (S'g'd) George Jeffereys, deputy U. S. marshal.

(File-mark:) U. S. circuit court. Filed June 22, 1886. Timothy Griffith, clerk.

3 United States Circuit Court, Southern District of New York.

CHARLES M. HIGGINS and JOHN GIANELLA
vs.
WILLIAM D. KEUFFEL and HERMAN ESSER. } In Equity.

To the judges of the circuit court of the United States for the southern district of New York:

The bill of complaint of Charles M. Higgins and John Gianella, both citizens of the United States and residents of the city of Brooklyn, in the county of Kings and State of New York, against William D. Keuffel and Herman Esser respectfully shows—

That your orators, Charles M. Higgins and John Gianella, *as* co-partners doing business under the firm name and style of Charles

M. Higgins & Co., at the cities of New York and Brooklyn, as manufacturers of various articles, among others, inks, and principally a liquid drawing ink, hereinafter described, and have been so engaged in the said business under such firm name ever since the first
4 day of May, 1885, and prior to that date and ever since the first day of January, 1880, your orator, the said Charles M. Higgins, was engaged in and carried on the said business of manufacturing liquid drawing inks at said cities of New York and Brooklyn, and prior to the time he commenced the said manufacture the said Charles M. Higgins invented and produced a liquid drawing ink which possessed the quality of being insoluble, indelible, or proof to water when dried, and ever since the invention of the same and at the present time your orators, as such copartners, or the said Charles M. Higgins alone, has been extensively engaged in the manufacture and sale thereof.

That subsequent to the said invention the said Charles M. Higgins composed, designed, or devised, and thereupon adopted, as a name or title for the said liquid drawing ink and as a label for the same in the commerce or sale thereof the words " water-proof drawing ink," and since that time the said ink has become widely, favorably, and distinctively known by the said name or title " water-proof drawing ink," and has been extensively sold under the said label.

That your orator, the said Charles M. Higgins, was the first person to produce and sell a liquid drawing ink having such insoluble, indelible, or water-proof quality, and was the first person to adopt and use the term " water-proof " as applied to an ink, and the first person to compose, design, and adopt and use a label for an ink consisting of the words " water-proof drawing ink," and as such being entitled to the sole and exclusive right to the use of the same, and desiring to have and secure to himself and his assigns the full, sole, and exclusive right to the said original label so composed, designed, or devised by him, he did on the 27th day of October, 1883, enter and register the same in the United States Patent Office, pursuant to the statute in such case made and provided, and did duly comply with all the requirements of the said statute, and thereafter the
5 Commissioner of Patents did duly issue to the said Charles M. Higgins a certificate of registration of the said label " water-proof drawing ink," No. 3693, duly signed and sealed, on the 20th day of November, 1883, the said Charles M. Higgins being then as now a citizen of the United States.

That the said label was thus deposited and said certificate granted and issued and said registration made before the said label was used or published by your orators or either of them.

And your orators further show that they are informed and believe and so allege that the said registration secured to the said Charles M. Higgins and his assigns and licensees *to* the exclusive right to the use of the said label for the full term of twenty-eight years from the day of the date of the registration thereof.

That heretofore and on or about the 1st day of May, 1885, the said Charles M. Higgins granted and sold to the said firm of Charles M. Higgins & Co., composed of your orators aforesaid, the full and

exclusive right and license to use the said label for the full term of five years from that day, and ever since that date and at the present time the said firm have been and now are entitled to the exclusive right to the use of the same and to all the gains, profits, and advantages arising therefrom.

And your orators further show that they have paid out and expended large sums of money upon the manufacture of said inks and upon machinery, plant, and apparatus for the manufacture of the same and for the printing and engraving of the said label, and have paid out and expended large sums of money for advertising the said ink, and have by advertising and various other ways and means brought to the notice and attention of the public generally, and especially to the notice of persons who use or sell drawing inks, the said liquid drawing ink so manufactured by your orators,
6 and the same is now and for a long time has been well and favorably known to the public generally and to such persons by and under your orators' said label of "water-proof drawing ink," and prior to the infringement hereinafter complained of your orator, Charles M. Higgins, received from the sales made by him of said article under the said label as aforesaid large gains and profits sufficient to reimburse the expense and remunerate the care, labor, and trouble bestowed on the same.

And your orators further show that your orator, Charles M. Higgins, being in receipt of large sums of money, the proceeds of the sales of said article as aforesaid, the said William D. Keuffel and Herman Esser, of New York city, in the southern district of New York, as copartners under the firm name and style of Keuffel & Esser, they being also engaged in the sale of drawing inks, and well knowing the rights of your orators in the premises, and that the said label had been duly registered as aforesaid, deliberately, after due notice, and intending to infringe the said label and the rights of your orators thereunder, at the city of New York aforesaid and elsewhere, on or about the 15th day of October, 1884, and on or about the 13th day of March, 1886, and at divers other times before and after those dates, without the allowance or consent of your orators or either of them, printed and used and placed upon bottles of drawing ink, of which they have sold large quantities, the exact number of which is unknown to your orators, a label alike or substantially alike the said label of your orators and containing the identical words of your orators' said label, similarly set or collocated as your orators' said label, to wit, "water-proof drawing ink," which label the defendants still continue to print and use and to place upon the said article so sold by them, well knowing that the same is an infringement of your orators' label and of their rights there-
7 under, and the said defendants have announced and threatened to continue the said infringement in future, the protests, expostulations, and warnings of your orators to them to the contrary notwithstanding, whereby your orators have sustained great damage, detriment, and injury, and will sustain in future great damage, detriment, and injury unless the unlawful acts of the said defendants are restrained and prevented.

All of which acts, doings, and pretenses are contrary to equity and good conscience and tend to the injury of your orators in the premises.

That heretofore and on or about the 11th day of February, 1886, the said Charles M. Higgins duly assigned, transferred, and set over unto your orators as copartners composing the said firm of Charles M. Higgins & Co. all claims and causes of action which he then had or was entitled to against the said defendants for or by reason of the aforesaid infringement.

In consideration whereof and forasmuch as your orators are remediless in the premises at law and can have no adequate relief save in a court of equity, where matters of this and like nature are properly cognizable and relievable, and to the end that the said William D. Keuffel and Herman Esser may appear and answer all and singular the matters and things hereinbefore set forth and complained of, particularly the number of bottles of ink they have sold and also the number they have on hand on which they have placed their said simulated or false label, and that they may be restrained by an injunction issuing out of this court from selling or exposing for sale bottles of drawing ink with the said label which they now use on the same or with a label on the same which contains the words "water-proof drawing ink," and set or arranged in the same order as used by your orators, and from in any other way infringing your orators' said label and their rights thereunder, and that they may render an account of the number of bottles they
8 have so sold and pay over to your orators the profits arising from such sales or the loss or damage which your orators have sustained by reason thereof, and that they may be ordered to surrender and deliver up all copies of their said simulated or false label now on hand and the plates for making or printing the same to one of the officers of this court to be cancelled and destroyed, and be ordered to pay to the plaintiffs their costs, and that your orators may obtain such other and further relief as to this honorable court may seem meet or as equity may require—

May it please this honorable court to grant unto your orators a writ of subpœna, directed to the said William D. Keuffel and Herman Esser, commanding them, at a day certain and under a penalty to be therein inserted, personally to be and appear before this honorable court, then and there to answer the premises and to stand and abide such order and decree therein as to this honorable court shall seem agreeable to equity and good conscience.

CHARLES M. HIGGINS.
JOHN GIANELLA.

THOMAS J. KEIGHARN,
Solicitor and of Counsel for the Complainants.

SOUTHERN DISTRICT OF NEW YORK, } ss:
City and County of New York, }

CHARLES M. HIGGINS, being duly sworn, says he is one of the complainants above named; that the foregoing bill of complaint is true

to his own knowledge except as to the matters therein stated to be alleged on information and belief, and as to those matters he believes it to be true.

(S'g'd) CHAS. M. HIGGINS.

Sworn to before me this 12th day of June, 1886.

(S'g'd) ROBERT JACKSON,

[NOTARIAL SEAL.] *Notary Public, Kings & N. Y. Co's.*

9 United States Circuit Court, Southern District of New York.

CHARLES M. HIGGINS and JOHN GIANELLA
vs.
WILLIAM D. KEUFFEL and HERMANN ESSER. } In Equity.

Please note our appearance in the above-entitled suit for William D. Keuffel and Hermann Esser, the defendants therein.

Dated New York, July 3rd, 1886.

Yours, &c., GOEPEL & RAEGENER,
280 *Broadway, New York City.*

To Timothy Griffith, Esq., clerk.

(Endorsed:) United States circuit court, southern dist. of N. Y. Charles M. Higgins & *al. vs.* William D. Keuffel & *al.* Notice of appearance. Goepel & Raegener, sol'rs for def'ts, 280 B'dway, N. Y. city.

(File-mark:) U. S. circuit court. Filed July 3, 1886. Timothy Griffith, clerk.

10 United States Circuit Court, Southern District of New York.
In Equity.

CHARLES M. HIGGINS and JOHN GIANNELLA
vs.
WILLIAM D. KEUFFEL and HERMAN ESSER.

The answer of William D. Keuffel and Herman Esser, defendants, to the bill of complaint of the above-named complainants.

These defendants, now and at all times hereafter saving and reserving unto themselves all and all manner of benefit and advantage of exception that can or may be had or taken to the many errors, uncertainties, and insufficiencies in the said bill of complaint contained, for answer thereto or unto so much thereof as they are advised it is material or necessary for them to make answer unto, answering, say:

11 First. That the defendants do not know and are not informed, save by said bill of complaint, whether the said complainants are copartners and have been and are now in business as alleged in said complaint, or whether the complainant, Charles M. Higgins, was engaged in and carried on such business at the times alleged in said complaint, or whether at the time stated in the said

complaint or at any time the said Higgins invented and produced a liquid drawing ink possessing the qualities alleged in said complaint, or whether since said alleged invention the complainants as copartners have been and now are engaged in the manufacture and sale thereof, and leave the complainants to make such proof thereof as they may be advised is material.

The defendants, further answering, say that they do not know and are not informed, except by said bill of complaint, whether subsequent to said alleged invention the said Charles M. Higgins composed, designed, or devised or adopted as a name or title for the said liquid drawing ink or as a label for the same in the commerce or sale thereof the words " water-proof drawing ink," all as is alleged in said bill, and leave the complainants to make such proof thereof as they may be advised is material; but defendants deny that since that time or at any time the said ink has become or is widely favorable or distinctively known by the said name or title " water-proof drawing ink."

The defendants, further answering, deny that the said Charles M. Higgins was the first person to produce and sell a liquid drawing ink having such insoluble, indelible, or water-proof qualities; they do not know and are not informed save by said bill whether the said Charles M. Higgins was the first person to adopt and use the term or word " water-proof " as applied to an ink, or was the first person to compose, design, or adopt and use a label for an
12 ink consisting of the words " water-proof drawing ink," and they leave the complainants to make such proof thereof as they may be advised is material; but they deny that the said Charles M. Higgins ever became or was entitled to the sole and exclusive right to the use of the same.

Defendants, further answering, say that they do not know and are not informed, save by said bill of complaint, whether the said Charles M. Higgins entered and registered the said label in the United States Patent Office or complied with all the requirements of the statute in such case made and provided, all as alleged in said bill of complaint, and they leave the complainants to make such proof thereof as they may be advised is material.

The defendants, further answering, say that they do not know and are not informed, save by said bill of complaint, whether the label was thus deposited and any such certificate granted or issued to said complainants, or whether said alleged registration was made before the label was used or published by said complainants, as alleged in said bill of complaint, and they leave the complainants to make such proof thereof as they may be advised is material.

The defendants, further answering, deny that the said alleged registration secured to the said Charles M. Higgins or his assigns or licensees the exclusive right to the use of the said label for the term of twenty-eight years or for any term.

The defendants, further answering, allege that they do not know and are not informed, save by said bill of complaint, whether the said Charles M. Higgins granted a license to use the said label for the term of five years to these complainants, as alleged in said bill,

and leave the complainants to make such proof thereof as they may be advised is material; but these defendants deny that ever since that date or at the present time the said firm have been or
13 now are entitled to the exclusive right to the use of the said label or to any of the profits, gains, and advantages arising therefrom.

The defendants, further answering, say they do not know and are not informed, save by said bill of complaint, whether the complainants have paid out and expended large sums of money upon the manufacture of said inks, or whether the same have paid out and expended large sums of money for advertising said ink or bringing the same to the notice and attention of the public, or whether the said Charles M. Higgins, prior to the alleged infringement complained of in said bill or at any time, received from the sales made by him of said article under the said label large or any gains and profits, and they leave the complainants to make such proof thereof as they may be advised is material.

The defendants, further answering, deny that they have ever, deliberately or in any way, at the city of New York or elsewhere, printed or used or placed upon bottles of drawing ink and sold by them a label alike or substantially alike the said label of complainants or containing the identical words of said complainants' label, similarly set or collocated, or that they are now printing, using, — placing upon bottles for use and sale a label alike or substantially alike the complainants' label, or that they have infringed or intended to infringe the said label of the complainants or any of their rights thereunder; and they deny that they have announced or threatened to continue any infringement upon the said label of complainants. They allege, on the contrary, that the label used by them on the inks manufactured and sold by them is substantially unlike and different from the said label of the complainants, and is not an infringement upon the said alleged rights of the complainants and of their said label.

And the defendants further deny that the complainants
14 have sustained any damage, great detriment, or injury by any unlawful acts of these defendants.

The defendants further deny that any of their acts, doings, or pretences are contrary to equity and good conscience and tend to the injury of the said complainants.

The defendants, further answering, say that they do not know and are not informed, save by said bill of complaint, whether the said Charles M. Higgins assigned to the complainants all or any claims or causes of action which he then claimed to have or to be entitled to against these defendants for or by reason of the aforesaid alleged infringement.

And the defendants, further answering, say that the registration of the said label and of the words "water-proof drawing ink" and the alleged exclusive rights of the complainants to the same are void and of no effect in law, because the said words and label are descriptive and describe the quality and attributes of said ink, and

are therefore public and common property, and said complainants have no right to any exclusive property therein.

And the defendants, further answering, say that the registration of the said label and of the words "water-proof drawing ink" and the alleged exclusive rights of the complainants to the same are void and of no effect in law, because the said words and label are not proper subject-matter for registration in the Patent Office as a label and for protection under the laws of the United States and cannot lawfully form and be a good and valid label, and that said complainants have acquired and possess no exclusive rights to said label or the words therein contained because of such registration or adoption.

And these defendants pray the same benefit of the facts and things herein set forth as if for the reason thereof they had demurred to said bill where a demurrer would have been proper, and the
15 same benefit thereof as if they had specially pleaded to said bill where a special plea would have been proper; and they submit to this honorable court that said complainants have no right to any further answer to said bill or any part thereof than is hereinbefore contained, and *has* no right to any injunction, account, or other relief prayed for in said bill; and these defendants pray to be hence dismissed with their reasonable costs and charges in this behalf most wrongfully sustained.

HERMANN ESSER.
GOEPEL & RAEGENER,
Solicitors for Defendants, Stewart Building, New York City.

LOUIS C. RAEGENER, *Of Counsel.*

STATE OF NEW YORK, }
County of New York, } *ss:*

HERMANN ESSER, being duly sworn, says that he is one of the defendants in this action, and that the foregoing answer is true to the knowledge of this deponent except as to the matters therein stated to be alleged on information and belief, and that as to those matters he believes it to be true. Deponent further says that the reason why this verification is not also made by William D. Keuffel, the other defendant hereto, is because said William D. Keuffel is and since the commencement of this suit has been out of the southern district of New York, to wit, in Europe, and could not, therefore, verify the same; that deponent is an agent and partner of said William D. Keuffel and is personally acquainted with all of the business matters of said Keuffel and with the matters sued upon herein, and that the foregoing verification is made by him as
16 agent of said Keuffel as well as individually; that the sources of his belief as to all matters in said answer not stated upon his knowledge are statements made to him and facts arising in connection with his said business.

HERMANN ESSER.

Sworn to before me this 31st day of July, 1886.

ALAN D. KENYON,
[L. S.] *Notary Public, N. Y. Co.*

(Answer endorsed:) U. S. circuit court, southern district of N. Y. In equity. Charles M. Higgins and John Gianella *vs.* William D. Keuffel and Hermann Esser. Answer. Goepel & Raegener, defendants' solicitors, New York.
(File-mark:) U. S. circuit court. Filed Aug. 2, 1886. Timothy Griffith, clerk.

U. S. Circuit Court, Southern District of New York.

CHARLES M. HIGGINS and JOHN GIANELLA
vs.
WILLIAM D. KEUFFEL and HERMAN ESSER.

The replication of Charles M. Higgins and John Gianella, the above-named complainants, to the answer of William D. Keuffel and Herman Esser, the defendants.

These repliants, saving and reserving to themselves now and at all times hereafter all and all manner of benefits and advantages of exception which may be had or taken to the manifold insufficiencies of the said answer, for replication thereto say that they will
17 aver, maintain, and prove their bill of complaint to be true, certain, and sufficient in the law to be answered unto, and that the said answer of the said defendants is uncertain, untrue, and insufficient to be replied unto by these repliants; without this, that any other matter or thing whatsoever in the said answer contained material or effectual in the law to be replied unto and not herein and hereby well and sufficiently replied unto, confessed and avoided, traversed or denied, is true; all which matters and things these repliants are and will be ready to aver, maintain, and prove as this honorable court shall direct, and humbly pray as in and by their said bill they have already prayed.

THOMAS J. KEIGHARN,
Solicitor for Complainants.

(Replication endorsed:) U. S. circuit court, southern dist. of N. Y. Charles M. Higgins *et al. vs.* William D. Keuffel *et al.* Replication.
(File-mark:) U. S. circuit court. Filed Sept. 6, 1886. Timothy Griffith, clerk.

Circuit Court of United States, Southern District of New York.

CHARLES M. HIGGINS and JOHN GIANELLA
vs.
WILLIAM D. KEUFFEL and HERMAN ESSER. } In Equity.

Proofs taken on part of the complainants before me, Joseph J. Sullivan, acting as special examiner, by consent of the parties.

18 Met pursuant to notice.

Present: Thomas J. Keigharn, Esq., counsel for complainants.; Louis C. Raegener, counsel for defendants.

NEW YORK, *Oct. 25th*, 1886.

The defendants admit that the complainants are copartners in trade, doing business under the firm name of Charles M. Higgins & Co., and carry on the business alleged in the bill of complaint.

Defendants also admit that the complainants have been granted and now hold and own an exclusive license to use the label as alleged in the bill of complaint.

CHARLES M. HIGGINS, a witness produced on the part of the complainants, being first duly sworn to tell the truth, the whole truth, and nothing but the truth, in answer to interrogatories propounded by Mr. KEIGHARN says:

Direct examination:

1 Q. What is your name, age, residence, and occupation?

A. Charles M. Higgins; age, 32; residence, 197 Ninth street, Brooklyn; occupation, solicitor of patents and manufacturer of carbon inks, drawing inks, and other articles.

2 Q. You are one of the complainants in this action, are you not?

A. I am.

3 Q. When did you first begin the manufacture of carbon inks?

19 A. I first began the making of carbon inks between 1872 and 1874. I was then employed as the draughtsman and specification writer in the office of a patent solicitor and paid a good deal of attention to the getting up of a satisfactory drawing ink, of which I felt the need. I then invented a method of preparing a liquid ink from India stick ink, which was used almost exclusively in the office, and was also used by several other draughtsmen to whom I gave some of the ink and was pronounced very good. I continued to use the ink myself for some years afterwards.

Interruption.—The right of cross-examination and interposing objections reserved to defendants' counsel; adjournment for cross-examination to be to November 8th, 1886, at 11 a. m.

And when I left the office I left the formula there from which they prepared the ink themselves afterwards.

After that I experimented for a long time with a view to discover the secret of the composition of India ink and to be able to make a

new India or carbon ink equal or superior to the genuine or Chinese India ink, and particularly to prepare a carbon ink for drawing or other purposes in a perfectly liquid state which would keep liquid and free from decay for a great length of time. After many experiments abandoned and repeated at different times I perfectly succeeded in accomplishing my object in 1878 or 1879.

4 Q. When you completed your experiments in 1878 or 1879 had you then made two kinds of liquid drawing ink?

A. I had.

5 Q. Please state what the distinctive qualities of those two inks were—I have reference to the soluble or water-proof characteristics of the ink.

20 A. My object in preparing the two kinds of ink was partly to correspond with the two kinds of stick ink then in use—that is, the one being the "India or Chinese ink," which is a fine, soft, glossy, soluble ink, which is the kind most widely known and used by draughtsmen; the other is the Japanese ink, a very hard, dull, black ink, which is insoluble when dried. One of my liquid inks was soft and insoluble, and could be used for either line drawing or shading or tinting with the brush, but could not be used for lines which required to be washed over with color. My second kind of liquid ink was insoluble when dried on the paper, and could be washed over with water or water colors without blurring or dissolving. Before that time the only carbon ink that had that quality was the Japanese stick ink, before referred to, which had to be ground in water, and it was very hard and difficult to grind, and was used but slightly by draughtsmen in general.

— Q. Please state what year it was that you fully completed your compositions for the inks you have been speaking about.

A. In 1879 the two kinds of ink were perfected as a laboratory product, and in 1880 were a finished trade article, being introduced to the trade in that year.

7 Q. As I understand you, one of those inks was soluble and the other insoluble when dried on the paper?

A. Yes.

7½ Q. When you got these inks perfected as a trade article, as you say, did you then determine upon any names or titles by which they were to be sold as a commercial article in the trade? And, if so, please state fully how you came to select such names or titles.

A. I did. The general name that I adopted for all my inks was "American drawing ink," which title was registered in 1880.

21 To distinguish the two kinds of ink I called the soluble kind "general," it being adapted to general drawing, whether with the pen or brush, whereas the insoluble kind I called "water-proof." The "general" drawing ink we put up with a red label; the "water-proof" label was white; the same printed matter was on both labels.

8 Q. Please state what you did in the way of study and selection for the purpose of obtaining the name or title of the insoluble ink.

A. I spent a good deal of thought upon the subject to get a name which would be perfectly expressive—new in that line—and which

could not be misunderstood. The title "American drawing ink" was used generally for all my inks, but I wished to get a special name for the insoluble ink, and after study and reflection several names suggested themselves to me, and out of a large number I concluded that the word "water-proof" was what I wanted and was appropriate.

8½ Q. After that did you or not see the advisability of adopting a special label for that ink?

A. I did. After both kinds of inks had been on the market for some time and had proved quite successful, the "water-proof" having the largest sale, being novel in character and designation, and the word "water-proof" continuing to meet my approval and proving by the experience which we then had in the sale of the ink to be very expressive, easily understood by the trade and purchasers, and approved by them, I then devised a special label for the ink, in which that word was embodied as an essential part.

9 Q. With the object in view of procuring a label, did you then compose the sentence "water-proof drawing ink?"

A. I did.

10 Q. And immediately thereupon adopted it as your label for the insoluble ink?

22 A. I did.

11 Q. Did you take any steps after that to secure the exclusive right of that label?

A. I did, by applying for registration in the Patent Office under the laws of the United States relating to the registration of labels.

12 Q. State what you did to secure that registration.

A. I made application in due form to the Commissioner of Patents, preparing petition for registration, in which I duly described the label, and signed said application as sole proprietor, in conformity with the rules of the Patent Office in such cases, and mailed the same, with six copies of the label and the fee of six dollars, to the Commissioner of Patents.

13 Q. Look at the paper now shown you and state what that is.

A. That is a copy of the label which I sent for registry, and is the label I use upon my ink; I might add that on this copy appears the word and date of registry and the name and address of my agent, which did not appear upon the slips of paper I sent for deposit as my label.

Paper offered in evidence and same is marked "Complainants' Exhibit No. 1, Oct. 25, 1886, J. J. S."

14 Q. Did you receive from the Patent Office, after you sent the application and copies for deposit, any acknowledgment of the receipt of the same in that office?

A. I did, and now produce the official letter of allowance.

Letter offered in evidence and marked "Complainants' Exhibit No. 2, October 25, 1886, J. J. S."

23 15 Q. Did you afterwards receive from the United States Patent Office a certificate of the registration of such label and a copy of the record?

A. I did, and now produce the same.

Paper produced offered in evidence and marked "Complainants' Exhibit No. 3, October 25, 1886, J. J. S."

16 Q. How soon after the registration did you begin to use that label?

A. I can't say how soon, but very soon after the registration.

17 Q. And from the time you began to use the label you have continued to use it exclusively as the label of your insoluble ink down to the present time?

A. I have.

18 Q. Please state whether the sales of the insoluble ink made under this label have been large or otherwise.

A. It has been largely and extensively sold and has become a well-established article in the trade of drawing materials all over the United States, and has also been sold in Canada and Mexico.

19 Q. Is this label used on all bottles of this ink sold by you?

A. It is.

20 Q. Is it stamped and printed on all the boxes in which you supply it to the trade?

A. The label is not only put on the bottle itself, but it is also printed conspicuously on the thick paper wrapper in which the bottle is wrapped, and is also printed prominently on the wooden boxes in which the wrapped bottles are supplied to the trade in quantities or dozens.

21 Q. From the year 1872 to 1874, when you first turned your attention to the study of drawing inks, down to the present time, have you been familiar with the various inks of that character which have been on the market and with that branch of the ink trade generally?

24

A. I have.

22 Q. Please state fully what you did during all these years to familiarize yourself with that business.

A. Being a draughtsman, I saw the need of a satisfactory liquid ink, and was constantly on the lookout for such. The only liquid India ink that had any extensive use or sale at the time was that made by and known as Winsor & Newton's ink, imported from London, but this was but little used as compared with the stick ink. This was probably the best ink obtainable at the time, but was objectionable for many reasons, which were that it was corrosive to the pens, the carbon would settle in the fluid, and the ink would often readily smear when on the paper. Besides this ink, a very great many attempts had been made by different parties to make a liquid India or carbon ink which would hold the carbon in suspension and not decay and have the other necessary qualities desired by draughtsmen, but no thoroughly satisfactory ink of this character was ever produced, to my knowledge, before the invention of my ink. I made myself familiar with all the inks that were obtainable in the market during that period.

23 Q. Can't you state some of the inks of that character, if any such there were, on the market?

A. The only ink of any consequence was the ink of Winsor & Newton, before referred to. Besides that many dealers in this country would prepare, in a small way, some liquid ink from the broken "India ink" and put it up for immediate sale. This never seemed to be carried much in stock or pushed much in sales, as it would become decomposed rapidly and was very offensive, and became useless in a short time. Among others, I know that Keuffel & Esser, the defendants herein, put up an ink of that kind, which they
25 called "Keuffel & Esser's liquid india Ink," and others tried to do the same, but they were all considered as practical failures, and never succeeded in being much adopted by draughtsmen.

24 Q. Then, notwithstanding your familiarity with the market, you cannot recall any but the two inks you have referred to?

A. There were several other like attempts, as I have already indicated.

25 Q. As I understand you, these inks had no special name, except the generic name of "India ink," or something similar to that?

A. That is so, to the best of my recollection.

26 Q. Did you not during this period have frequent conversations on this subject with persons who were familiar with and engaged in that branch of the ink trade for a great many years?

A. I did; and I might say that I enquired extensively and largely among dealers in that trade, and, moreover, prior to 1874 I was employed for two or three years in the trade of paints and artists' materials, and was frequently in the stores in which such things as draughtsmen's and artists' materials were kept and sold.

27 Q. From your early connection with this trade, as you have just testified, and also from the inquiry and research you have made as to the existence of inks of this character, do you consider yourself familiar with all the articles of drawing ink that were offered for sale during this period?

A. I do.

28 Q. Testifying from your knowledge of the trade, do you know whether the word "water-proof" has ever been applied to an ink before it was adopted by yourself?

A. Never, to my knowledge.

29 Q. Testifying from the same knowledge, can you say
26 whether or not such a label as you use—that is, "water-proof drawing ink"—has ever been used before it was used by you?

A. Never, to my knowledge.

30 Q. You have referred to an ink made by Keuffel & Esser some time prior to the time you made the inks you have testified to. Did they apply to that ink in any way the word "water-proof?"

A. They did not, and previous to the invention of my ink there was no liquid India or carbon ink to which that word could be applied.

31 Q. Will you please explain the last part of your last answer—that is, that the word "water-proof" could not be applied to any ink previous to your invention?

A. Because there was no liquid India or carbon ink on sale previous to my invention which was indelible, insoluble, or proof to the action of water when dried on the paper.

Adjourned to Oct. 26, 1886, at 2 p. m.

NEW YORK, *Oct.* 26, 1886—2 p. m.

Met pursuant to adjournment.
Present: Thos. J. Keigharn, Esq., counsel for complainants.

Examination of the witness, CHAS. M. HIGGINS, resumed by Mr. KEIGHARN:

32 Q. Are you familiar with the manner in which the defendants are now putting up the drawing ink they offer for sale?
A. I am.
33 Q. You have been familiar with the manner in which they have put up their liquid drawing inks for the last four or five years?
A. I have.
27 34 Q. In the last two questions what I referred to was, as I supposed you understood, the manner and style as to the shape of bottle in which the article is sold and the label thereon.
A. I so understand you.
35 Q. Look at the bottle of ink which I hand you and state whose ink that is.
A. Keuffel & Esser's ink.

Bottle offered in evidence and marked "Complainants' Exhibit No. 4, Oct. 26, 1886, J. J. S."
The defendants admit that they have been selling ink put up in bottles and covered by a label in all respects similar to Complainants' Exhibit No. 4, of this date, before the commencement of this suit, and are now so selling, and also admit that the label on said exhibit is the defendants' label.

36 Q. Can you state how long the defendants have been selling ink in the bottle and under the label Complainants' Exhibit No. 4?
A. As well as I remember and can determine, they commenced selling ink in that shape of bottle in the early part of 1884, but the label "water-proof drawing ink" was not used on that shape of bottle until the latter part of 1884.
37 Q. Now, prior to the time they began to use that bottle, Exhibit No. 4, were they putting up a liquid drawing ink in any other shape of bottle?
A. Yes; they at first put up liquid drawing ink in a tall, slender, square-shaped bottle, which had been used commonly by other parties and previous to the introduction of my ink.
38 Q. Do you mean that Keuffel & Esser used that tall, slender bottle before the introduction of your ink on the market?
A. I do.
28 39 Q. Well, after the introduction of your ink did the defendants make a change in the shape of their bottle?

A. They did.

40 Q. Did this change which they made in their bottle bring its shape into any resemblance of the bottle you were then using?

A. It was exactly copied after my shape of bottle, and I considered it an exact imitation.

41 Q. Will you please describe the shape and appearance of both bottles?

A. The shape was a low, round or cylindrical shape, broad in comparison with its height, so that it would not tip over easily, with a molding on the shoulder or breast of the bottle. The bottles were the same size, holding one-half ounce, the body of each bottle being about one and five-eighths inches in diameter and about seven-eighths of an inch high at the breast or shoulder. The necks in both were the same height and diameter.

42 Q. At the time you began to use the bottle you have just described was there any bottle of similar shape and appearance in use in the drawing-ink trade.

A. None whatever; it was new with me and one of the important characteristics of my article.

43 Q. Did the fact that the defendants began, as you say, to put up ink in a bottle like yours lead to any controversy between you and them?

A. It did; I notified them to stop imitating the shape of my bottle, my shape being distinguishable from all others then in the market.

44 Q. Did you, in connection with the defendants' use of this bottle, have any conversations with the defendants or either of them? And, if so, please state what that conversation was.

A. Yes. After writing to Keuffel & Esser about the matter Mr. Keuffel called on me and we fully discussed the matter, and he readily agreed to stop using that bottle.

29 45 Q. Prior to his interview with you had you threatened to bring a suit against him if he did not discontinue the use of that bottle?

A. I did.

46 Q. Did he then discontinue the use of that bottle?

A. He did; so far as I could learn.

47 Q. What shape of bottle did he begin to use then, upon discontinuing the use of your shape?

A. He began to use the shape of bottle shown in Exhibit 4, but did not use at first on such bottles the label on Exhibit 4.

48 Q. What was the label he used on it?

A. The label I now produce, which was "photo drawing ink."

49 Q. Where did you get this label you now produce?

A. From a bottle bought in defendants' store, and I took the label off the bottle with my own hands.

Label offered in evidence and marked "Complainants' Exhibit No. 5, October 26, 1886, J. J. S."

50 Q. I understand you to say when Mr. Keuffel called upon you

he promised you to give up every feature which you pointed out to him as an imitation of your bottle. Am I right?

51 Q. Yes; he agreed to give up the shape of my bottle, and also the use of a pointed quill inserted in the cork for filling the ink into the drawing pen, which was original with my package and one of its taking characteristics.

52 Q. At the date of this interview were the defendants using the word "water-proof" on their bottles at all?

A. They were not.

53 Q. After Mr. Keuffel agreed to yield to you all you
30 claimed as your rights in the bottle did you say anything to him in reference to your exclusive right to the label "water-proof drawing ink"?

A. I did. I called his attention to my exclusive right to that label and cautioned him against his using it on the new bottles or packages which he was going to get up.

54 Q. What did he say in reply to your suggestion in this respect?

A. He agreed positively not to use that. He expressed himself as not wanting to or caring to use it, and did not seem to value it, and proposed to use a different title.

55 Q. Was anything said by you to him in reference to embodying his promises to observe your rights in an agreement?

A. Yes. It was understood before we parted that he was to write me a letter in which he would acknowledge all the points upon which we had agreed, and, hearing nothing from him for some time after this, I again wrote him, enclosing an agreement which I had drafted covering the points which we had agreed upon and asking his signature thereto.

56 Q. Did you afterwards hear from him?

A. I had a couple of letters from the firm, in one of which it was stated that Mr. Keuffel was out of town and it would be attended to on his return. After his return I received a letter, which I now produce.

Letter offered in evidence and marked "Complainants' Exhibit No. 6, Oct. 26, 1886, J. J. S."

57 Q. In view of the fact that at the date of these interviews with Mr. Keuffel his firm was not then using the word "water-proof," what was it that prompted you to caution him against using it in future?

31 A. Because others had used it, and I had instructed my attorney to proceed against one person who was making a bold use of the word, and as all those parties acquiesced in my right to its use I intended to save myself and his firm all further expense and trouble.

58 Q. At the time you made the complaints to Mr. Keuffel about his firm's bottle being an imitation of your bottle how many kinds of liquid black drawing ink had his firm for sale?

A. Three, to my knowledge. The first, and I believe the first and earliest, was an aniline black ink of a dark violet color, called "indelible (black) drawing ink," put up in tall, slender, square bottles.

The second was the carbon ink put up in the round bottle in imitation of mine and labelled "photo (black) drawing ink." The third was also a carbon ink, also in the same style of bottle like mine, represented to be insoluble when dry and labeled "indelible (black) drawing ink."

59 Q. At the time you made this complaint the bottles which you objected to were those used in the sale of the two last described inks?

A. They were.

60 Q. And after the complaint, as I understand you, two bottles like Complainants' Exhibit No. 4 were used instead of the two objectionable bottles.

A. Yes.

61 Q. Now, look at the bottle which I show you and tell me what that is?

A. That is the bottle made in imitation of mine, which I objected to, and labelled "indelible drawing ink," and which contains a carbon ink represented to be insoluble when dry.

62 Q. This bottle is one of the defendants', is it not?

A. It is one of the bottles of the defendants' and is the
32 identical bottle brought to me by Mr. Keuffel when we had the aforesaid interview.

Bottle offered in evidence, marked "Complainants' Exhibit No. 7, Oct. 26, 1886, J. J. S."

63 Q. As I understand you, the bottle which the defendants used before that interview for the "photo drawing ink" was like complainants' Exhibit No. 7.

A. It was.

64 Q. After the interview and the complaint you made in that interview was there any change made on the label of the defendants tall, slender, square bottles?

A. There was none.

65 Q. After the same time was there any change made in the label on the new bottle which contained the "photo drawing"?

A. There was no change.

66 Q. After the same time was there any change made in the label which the defendants placed on their new bottle containing the ink which they had before that interview sold in the bottle in evidence as Exhibit No. 7 and which they then labelled "indelible black drawing ink"?

A. There was; they abandoned that label for their insoluble drawing ink and adopted my label, "water-proof drawing ink," for the same kind of ink put up in their new bottles, contrary to the promises Mr. Keuffel made to me in that interview, such as shown in Exhibit 4.

67 Q. As I understand your last answer, what you mean to convey is this, that after the interview the ink in evidence as Exhibit No. 7, with its bottle, label, and everything pertaining to it, was given up and was not sold or heard of after that time.

A. Yes; to the best of my knowledge.

33 68 Q. And then, after that time, the defendants had only two liquid black drawing inks instead of three?

A. Such was the fact, to the best of my knowledge.

69 Q. Well, about how long after that did they again put a third ink upon the market?

A. About nine months, as well as I can determine; say about October, 1884.

70 Q. When this new or third ink appeared how was that bottled and labeled?

A. Exactly like Exhibit 4—that is, the ink.

Adjourned to October 27th, 1886, 11 a. m.

NEW YORK, *Oct.* 27, 1886—11 a. m.

Present: Thos. J. Keigharn, Esq., counsel for complainants.

Direct examination of the witness, CHARLES M. HIGGINS, resumed by Mr. KEIGHARN:

71 Q. The label on this bottle, Exhibit No. 4, containing the sentence "water-proof drawing ink," is the infringement complained of in this case, is it not?

A. It is.

72 Q. Now, as I understand your testimony, this infringement by the defendants did not commence until about nine months after your interview with Mr. Keuffel, in which you objected to the imitation of your bottles, and that would make the time of the present infringement to commence about the end of the year 1884. Am I correct?

A. Yes; such are the facts, as far as I know.

73 Q. Then the present infringement makes the second attempt on the part of the defendants, according to your testimony, to imitate your style of supplying your ink to the trade. Am I correct?

34 A. Yes; in the first instance they imitated my bottle; in the second they copied my label.

74 Q. Do you know whether or not the defendants issued regularly or at certain periods catalogues of the goods they offered for sale to the trade?

A. Yes; they do. Every two years they issue new or revised catalogues.

75 Q. Do you or not know whether your inks have been quoted in any of these catalogues as for sale by the defendants?

A. Yes; the defendants, in common with other dealers, have sold my inks, and they appear quoted in the defendants' catalogues.

76 Q. Can you tell the years in which they have been quoted?

A. Yes; in their catalogues for 1883 my inks are so quoted.

77 Q. Do the defendants issue a catalogue every year?

A. Not that I know of, but only every two years.

78 Q. Have they issued a catalogue for the year 1885?

A. They have.

79 Q. Did they issue a catalogue for the year 1881?

A. They did.

80 Q. Is your ink quoted in that catalogue for 1881?

A. It is not. My ink had not become extensively known or used at that time.

81 Q. Please look at the paper I show you and say what it is.

A. It is page 193 of Keuffel & Esser's catalogue of 1883.

82 Q. That is the page whereon your ink is quoted, is it not?

35 A. It is, on the last line, reading "No. 1169, Higgins' liquid ink, general or water-proof."

Page 193 of book above referred to offered in evidence and marked "Complainants' Exhibit No. 8, Oct. 27, 1886, J. J. S."

83 Q. Please look at the page I now point out to you and say what that is.

A. It is page 193 of the defendants' catalogue of 1885.

84 Q. Is your ink quoted on that page?

A. It is not in any way referred to.

85 Q. Have you examined the book with the purpose to discover whether your ink is quoted in any way in that book; and, if so, what is the result of that examination?

A. I have examined the book and have not found any reference to my ink therein.

Page 193 of catalogue of 1885 offered in evidence and is marked "Complainants' Exhibit No. 9, Oct. 28, 1886, J. J. S."

86 Q. Look at the bottle which I now show you and state what it is.

A. That is the bottle in which my "American drawing ink" is put up, of the water-proof quality, under the label "water-proof drawing ink."

87 Q. Was that the bottle you were using at the time the defendants issued the catalogue from which Complainants' Exhibit No. 9 is taken?

A. It is.

Bottle offered in evidence and is marked "Complainants' Exhibit No. 10, Oct. 27, 1886, J. J. S."

88 Q. As alleged in the bill of complaint, you granted to

36 the firm of Charles M. Higgins & Co. a license giving them the exclusive right to use the label in question, did you not?

A. I did.

89 Q. When was that license granted and for what time?

A. It was granted for the full term of the partnership, which was five years from May 1st, 1885.

90 Q. Who compose the firm of Charles M. Higgins & Co.?

A. Myself and John Gianella, of Brooklyn, New York, the complainants in this action.

91 Q. Are you and Mr. Gianella citizens of the United States and of the State of New York?

A. We are.

92 Q. Prior to the commencement of this action did you make

any assignment of any claim and causes of action which you had against the defendants to the complainants in this action?

A. I did.

93 Q. Have you got that assignment? And, if you have, please produce it.

A. I have, and I now produce the same.

Paper handed witness by complainants' counsel.

94 Q. Is that your signature on that paper and did you deliver it to the firm of Charles M. Higgins & Co.?

A. It is my signature, and I delivered it to them.

Paper offered in evidence and marked "Complainants' Exhibit No. 11, Oct. 27, 1886, J. J. S."

95 Q. Please state briefly what you have done as an individual, and also what your firm has done, to bring your inks before the ink trade—to the notice of those who use that article and the public generally.

37 A. Immediately after perfecting the ink and getting it ready for the market I made an arrangement with a wholesale dealer in this city, in the trade of drawing ink and artists' materials—G. S. Woolman, of 116 Fulton street—to become sole agent for its introduction and sale, to advertise it, canvass it, and introduce it extensively in the trade, which he did. It has been advertised extensively in papers of the trades interested, in the catalogues of dealers, and by the distribution of circulars and samples.

96 Q. Please state at what time you began to extensively advertise your ink by the means you have described.

A. About the end of the year 1883 or the early part of 1884 this advertising was extensively begun.

97 Q. Has that arrangement which you made with Mr. Woolman been kept up by you and your firm down to the present time?

A. It has.

98 Q. And he has continued the methods you have described of advertising your ink to the present time?

A. He has.

99 Q. Have you and your firm expended any money in the construction of machinery and apparatus for the manufacture of your ink; and, if so, has the expenditure been large or otherwise?

A. Before the copartnership I spent a great deal of time and money in the perfection of processes, apparatus, and machinery and in the construction and erection of the same for the manufacture of the said inks. Since the copartnership the firm has spent considerable money—several thousand dollars—in the erection and equipment of a new factory and its contents, including stock, machinery, and fixtures.

Adjourned to Nov. 1, 1886, at 3 p. m.

38 NEW YORK, *Nov.* 8, 1886—11 a. m.

Met pursuant to adjournment.

Present: Thos. J. Keigharn, Esq., counsel for complainants; Louis C. Raegener, Esq., counsel for defendants.

The cross-examination of the witness, CHARLES M. HIGGINS, by Mr. RAEGENER:

100 X Q. Please look at Complainants' Exhibit No. 10 and mark thereon with the letter "A" that part which you consider your registered label, if you can do so.

A. I have marked it.

101 X Q. Please look at Complainants' Exhibit No. 3, being Commissioner of Patents' certificate, and point out the resemblances and differences between the label there shown and the label marked A on Exhibit No. 10.

A. They differ in the size and the style of letter and in the border line. The essential portion of the label is the same in both.

102 X Q. You have not any patent upon the method of making water-proof drawing ink or the product?

Objected to as immaterial and irrelevant and not in the nature of cross-examination.

A. I have not.

103 X Q. Before you made water-proof drawing ink there was no such ink in the market, was there?

A. There was no liquid India or carbon ink that had the water-proof quality, to my knowledge.

104 X Q. Is it possible to describe in language the ink re-
39 ferred to in the last question and answer first made by you by any plainer or more descriptive language than that of "water-proof drawing ink?"

A. Yes; it is possible to describe it well by other phrases and titles, but none so good in my opinion or to my liking so well as "water-proof drawing ink," the title which I have given it.

105 X Q. What do the words "water-proof drawing ink" mean?

Objected to as immaterial and irrelevant and as calling for the opinion of the witness.

A. They mean exactly what they say.

106 X Q. The defendants in this suit even now occasionally buy your "water-proof drawing ink," do they not?

A. I believe they do; so I am informed by my agent.

107 X Q. You do not claim that the defendants have sold your ink as your ink, do you?

A. I have no positive proof of the fact, but I claim that they adopted my label to get advantage of the name and reputation I had made for that ink.

108 X Q. Please look at Complainants' Exhibit No. 4, being a bottle of defendants' ink, and state in what respect it resembles or differs from Complainants' Exhibit No. 10, being your ink, having reference to the bottles and labels.

Objected to as irrelevant and immaterial so far as the question calls for a comparison of the bottles, and also that the bottles and labels are in evidence and speak for themselves.

A. Defendants' bottle is of about the same capacity as mine, the same height, and almost the same shape of breast and size of neck. In front elevation, in a cut or engraving, the bottles would
40 appear almost identical, the only difference being that defendants' bottle would appear a little the wider, due to its oval shape.

Each bottle contains the label "water-proof drawing ink," but in different typography. On defendants' bottle is a neck label with the words "Keuffel & Esser." On the neck of my bottle is the label "water-proof drawing ink." In my bottle there is a quill in the cork, and defendants' bottle appears to be without it.

109 X Q. You have testified that when you called the attention of the defendants to the way they put up their ink, as shown in Exhibit No. 7, claiming that the style of the bottle with the quill in the same resembles your bottle, as shown in Exhibit No. 10, that the defendants abandoned this style of putting up their ink?

A. Yes, as regards that special style of bottle and the quill.

110 X Q. Please look at Complainants' Exhibit No. 5 and state whether or not this is a label now used by the defendants and whether or not you claim it to be a violation of your registered "water-proof drawing ink" label.

A. Yes; this label is now used by the defendants, but it is no violation of my rights, and I make no objection to its use by them.

111 X Q. Who prints your labels?

A. G. H. Buek, formerly Buek & Lindner, of Centre and Walker streets, New York; also Thad. B. Mead, 98 Duane street, and another named Kellogg; I forget his address.

112 X Q. Who printed your labels in October, 1883?

A. Mead.

113 X Q. When did you sell your first bottle of water-proof drawing ink with the label on here in suit?

41 A. I cannot tell exactly; in the latter part of 1883 or the early part of 1884; most probably the latter.

114 X Q. What did you do toward publishing your label and what do you consider publication of the same?

Objected to as calling for the opinion of the witness and as calling for a conclusion of law so far as it calls for what he considers a publication.

A. I used it upon my goods and consider that a publication. I also sent out a circular to the trade informing them of the label and of its use and registration and my exclusive right to it and warning them not to infringe it.

115 X Q. When did you send out the circular?

A. About the 1st of March, 1884.

116 X Q. When, therefore, was the earliest date when you published the label here in suit?

A. I should say that the date of its earliest publication was some time between the date of registration and the date of the warning circular of March 1st, 1884. Its appearance or publication in the Official Gazette of the Patent Office of November 20th, 1883, was its earliest publication.

117 X Q. Did you at any time deliver to the Commissioner of Patents two or more copies of your label; if so, when?

A. I did, when the labels were deposited for registration, on or about October 27th, 1883.

118 X Q. Have you inserted in the several copies of your label here in suit the words "Entered according to act of Congress in the year 1883, by Charles M. Higgins, in the office of the Librarian of Congress," or the words "Copyright, 1883, by Charles M. Higgins," or, in fact, any other notice than the one in Complainants' Exhibit No. 10, to wit: "Registered 3693, 1883"?

42 Objected to as immaterial and irrelevant.

A. I have not printed the words first referred to, as the same would be inadmissible under the present law for registering labels, which forbids their registration in the office of the Librarian of Congress under the old copyright act, but according to the amended copyright act, known as the label act of 1874, which requires their registration in the United States Patent Office under the jurisdiction of the Commissioner of Patents. I therefore printed a notice on each label in these words: "Registered 3693, 1883," considering that that was ample notice to the public under the new law and being such as was generally used on labels registered under that act.

Redirect examination by Mr. KEIGHARN:

Adjourned to Nov. 10th, 1886, at 2 p. m.

NEW YORK, *Nov. 10th*, 1886—2 p. m.

Met pursuant to adjournment.

Present: Thos. J. Keigharn, Esq., counsel for complainants; Louis C. Raegener, Esq., counsel for defendants.

Defendants admit that at the time testified to by the complainant, Charles M. Higgins, he forwarded to the Patent Office six copies of the label shown on Complainants' Exhibit No. 3, and paid
43 the fee of six dollars, and that the said copies were so deposited, and the Commissioner of Patents thereupon issued to the said Higgins the certificate, Exhibit No. 3, and that all said acts were done on an application signed and presented by the said Higgins to the said Patent Office.

Redirect examination of CHARLES M. HIGGINS by Mr. KEIGHARN:

119 R. D. Q. By the 104 Q. you were asked if it was possible to describe the ink you manufactured by any plainer or more descriptive words than the words "water-proof drawing ink," and by your answer you say that it is possible to describe it well by other titles

and phrases. Please explain what meaning you intend to convey by that answer.

A. I meant to say that there are several words and phrases which will express the same sense or meaning as well as those that I have adopted, but that what I have adopted suited my taste, fancy, and judgment the best, and I therefore adopted them in preference to several others that occurred to me at the time I made the selection.

120 R. D. Q. Please state what words you have reference to in the last answer, omitting entirely from your answer any reference to phrases.

A. The several words which are referred to as being as good and descriptive as the word "water-proof" are "washable," "insoluble," and "indelible," and to these might be added the words "fixed" and "fast" in the sense in which they are used in reference to fixed or fast dyes or colors which do not run or wash out.

121 R. D. Q. Do I understand you to say that at the time you composed your label "water-proof drawing ink" you considered all or nearly all of the words which you refer to with the view of composing a label out of one of them?

44 A. I did; I considered particularly the words "washable," "insoluble," and "indelible."

122 R. D. Q. Is it or not also a fact that in composing your label you refrained from using at least one or more of the words referred to in your last answer because you had reason to believe that such word had been already used for a similar purpose by some other person or persons? And, if such is the fact, you can state by whom you understood the word referred to had been so used.

A. Yes. I excluded the word "indelible" because that term had been used by other parties to express exactly the same quality which I wished to express by the terms "washable" and "water-proof." The defendants, Keuffel & Esser, used the word "indelible" on an aniline black drawing ink, and many years previous to that and up to the present time Winsor & Newton, extensive manufacturers of London, had made a brown drawing ink having a similar quality, which they labeled "indelible brown ink." In making my original selection I was first most partial to the word "washable," but finally concluded that the word "water-proof" was preferable for our purpose.

123 R. D. Q. In your answer to the X Q. 104 and in one or two of your answers on the redirect examination you have used the word "phrase." Please have the kindness to state what meaning you intended to attach to that word in your answers to which I have referred you.

A. By the word "phrase" in that relation I mean the combination or collocation of words forming a complete label, name, or title, such as "water-proof drawing ink," "washable drawing ink," "insoluble drawing ink," "indelible drawing ink," and so on, such complete title forming, as I understand it, the essential part of a label.

124 R. D. Q. In your direct examination you testified that the

label "water-proof drawing ink" was printed conspicuously
45 upon the paper wrapper in which your ink is packed and sent out to the trade and also on the boxes in which quantities of the said bottles are encased. Look at the paper which I now hand you and state what that is.

A. That is the protecting paper wrapper in which we wrap the "water-proof drawing ink" and on which the label in question is printed and to which I referred in said former answer.

Paper offered in evidence and marked Complainants' Exhibit Wrapper, Nov. 10, 1886, J. J. S.

125 R. D. Q. Look at the piece of wood which I show you and state what that is.

A. That is the end of one of the wooden boxes in which the ink is shipped, with the label printed on it as we use it for the "water-proof drawing ink."

Piece offered in evidence and marked Complainants' Exhibit Box, Nov. 10, 1886, J. J. S.

Recross-examination waived.

CHAS. M. HIGGINS.

Subscribed and sworn to before me this 13th day of November, 1886.

JOSEPH J. SULLIVAN,

[SEAL.] *Notary Public, Kings and N. Y. Cos., Acting as Special Examiner under Consent of Parties.*

46 NEW YORK, *Nov.* 1, 1886—3 p. m.

Met pursuant to adjournment.

Present: Thos. J. Keigharn, Esq., counsel for complainants.

JOHN E. GAVIN, a witness produced on the part of the complainants, being first duly sworn, in answer to interrogatories propounded by Mr. KEIGHARN said:

1 Q. What is your name, age, residence, and occupation?

A. John E. Gavin; age, 25; residence, 132 E. 66th street, New York; occupation, clerk.

2 Q. During all of the year 1884 where were you employed?

A. In the office of Charles M. Higgins, 5 Beekman street, New York.

3 Q. Do you know Mr. William D. Keuffel, one of the defendants in this action?

A. I have seen him one or more times.

4 Q. Do you remember to ever have seen Mr. Keuffel in Mr. Higgins' office, No. 5 Beekman street?

A. I do.

5 Q. Can you state about when this was?

A. To the best of my recollection it was early in 1884.

6 Q. How many times have you seen him in that office?

A. To my knowledge but once.

7 Q. On that occasion did he, to your knowledge, have any conversation with Mr. Higgins?

A. He did.

8 Q. Can you state the substance of the conversation which took place between him and Mr. Higgins?

A. I believe I can.

47 9 Q. Please state fully the substance of what Mr. Higgins said to Mr. Keuffel and what Mr. Keuffel said to Mr. Higgins.

A. Mr. Higgins desired Mr. Keuffel's firm to discontinue the use of a bottle of a certain design, which they were then using to put up their drawing inks for the market and which Mr. Higgins considered to be an infringement of his rights to the said style of bottle. To the best of my recollection Mr. Keuffel conceded Mr. Higgins' right to said style of bottle and verbally agreed for his firm to change the style of bottle which they were then using in imitation of Mr. Higgins'.

10 Q. Do you or not recollect whether or not at that interview Mr. Higgins stated to Mr. Keuffel that he, Higgins, was entitled to the exclusive use of the label "water-proof drawing ink" and cautioned Mr. Keuffel against using those words on the new bottles which he was intending to get up?

A. To the best of my recollection he did.

11 Q. Please state, if you can, briefly, what occurred between them in reference to this label.

A. After they had discussed and settled on the bottle question Mr. Higgins called Mr. Keuffel's attention to his exclusive right to the use of the word "water proof" in connection with drawing inks. Mr. Keuffel seemed to be about leaving then, and in a general way acknowledged Mr. Higgins' right to the words, saying, in effect, "Certainly, certainly; that's all right."

12 Q. Well, before Mr. Keuffel departed was there any understanding between him and Mr. Higgins that he should write Mr. Higgins a letter embodying the promises that he had made or that they should be expressed in some other form in writing?

48 A. I believe there was.

13 Q. Can you state what was said with reference to that?

A. Mr. Higgins desired to have what they had verbally agreed upon expressed in a written agreement of some kind, and Mr. Keuffel, to my idea, wished to evade committing himself upon that point, but in a general way acquiesced.

JOHN E. GAVIN.

Subscribed and sworn to before me this 13th day of November, 1886.

[L. S.] JOSEPH J. SULLIVAN,
Notary Public, Kings and New York Counties, Acting as Special Examiner under Consent of Parties.

Cross-examination waived.

GEORGE S. WOOLMAN, a witness produced on the part of the complainants, being first duly sworn, in answer to interrogatories propounded by Mr. KIEGHARN says:

1 Q. What is your name, residence, and occupation?

A. George S. Woolman; aged 40; residence, Orange, New Jersey; occupation, merchant.

2 Q. Are you the agent having the exclusive right to sell the complainants' drawing inks?

A. I am.

3 Q. What mercantile occupation are you engaged in?

A. Of selling drawing instruments, materials, and optical goods.

49 4 Q. Are you not also engaged in the sale of drawing inks?

A. I am; that is a part of the drawing-material trade.

5 Q. How long have you been engaged in the sale of drawing inks?

A. For twenty-three years—sixteen years in New York, the balance in Philadelphia as clerk and merchant.

6 Q. How long have you been in business in New York on your own account?

A. Ten years and ten months.

7 Q. During all those 23 years you have been engaged in the drawing-ink trade have you been familiar with the various drawing inks that have been offered for sale during that period?

A. I have.

8 Q. Please state briefly the manner in which you became familiar with such articles during the period referred to.

A. By buying and selling the same. Originally stick "India ink" was used entirely. A prepared liquid "India ink," made by Winsor & Newton, of London, was afterwards brought upon the market. Subsequent to that liquid inks under the name of "indelible" were offered for sale by Keuffel & Esser, and later the "water-proof" and "general drawing ink" of Mr. Higgins were placed on sale.

9 Q. Now, testifying from your experience in the drawing-ink trade and from your familiarity with the names of the various drawing inks offered for sale during your connection with that trade, please state whether or not, to your knowledge, the word "water-proof" has ever been applied to a drawing ink prior to its application by Mr. Higgins.

A. It was not.

50 10 Q. Testifying from the same knowledge, please state whether or not the sentence "water-proof drawing ink" has ever been used as a label prior to its use by the complainant Charles M. Higgins.

A. It was not.

11 Q. Testifying from your knowledge of the drawing-ink trade, who was the first person to put on the market a liquid India or carbon ink having the quality of being insoluble or proof to water when dry?

A. I was; an ink made by Charles M. Higgins.

12 Q. Please state when your arrangements to act as agent for the sale of complainants' inks commenced.

A. In the summer of 1880.

13 Q. From the time of your arrangement with the complainants to sell their inks down to the present time what methods have you employed to advertise the complainants' inks and to bring them to the attention of the public generally?

A. By sending circulars to every draughtsman whose name I could obtain from that time to this, by having it placed and described in every mathematical catalogue that was issued by James W. Queen & Co. or myself since 1883, and by advertising in various trade papers.

14 Q. Please state in what business the firm of James W. Queen & Co. are engaged, and where.

A. Dealers in drawing instruments and materials of all kinds, surveying instruments, optical instruments, philosophical instruments for schools and colleges, in Philadelphia, and also a few years in New York, where they had a branch store. I act as their sole agent in New York city.

15 Q. Referring to the period covered by your agency for the complainants' inks, please state whether or not the advertising which you carried on during that time was more extensive at one period of it than another.

51 A. Certainly it was. I have constantly increased the advertising of it.

16 Q. Towards the end of the year 1883 or the beginning of the year 1884, did you adopt any new method of advertising to that previously used?

A. At that time I had it placed in the catalogues I have referred to, in addition to the other advertising by circulars.

Cross-examination waived.

G. S. WOOLMAN.

Sworn to before me this 17th day of November, 1886.

JOSEPH J. SULLIVAN,
Notary Public, Kings and New York Counties, Acting as Special Examiner under Consent of the Parties.

Complainants give notice that their *prima facie* case is closed.

EXHIBIT No. 2.

DEPARTMENT OF THE INTERIOR,
U. S. PATENT OFFICE,
WASHINGTON, D. C., *Nov.* 1, 1882.

Charles M. Higgins, 5 Beekman St., N. Y. city.

SIR: Your application for registration of label for "water-proof drawing ink" has been examined and allowed.

The certificate of registration will be issued and forwarded to you as soon as practicable in due order of business.

Very respectfully, BENJ. BUTTERWORTH,
Commissioner of Patents.

52 EXHIBIT No. 3.

No. 3693.

UNITED STATES OF AMERICA, PATENT OFFICE.

To wit: Be it remembered that on the twenty-seventh day of October, anno Domini 1883, Charles M. Higgins, of Brooklyn, New York, deposited in this office for registration a label of which the following is the title:

"Water-proof drawing ink," the right whereof he claims, as the sole proprietor, in conformity with the law of the United States entitled "An act to amend the law relating to patents, trade-marks, and copyrights," approved June 18th, 1874.

In testimony whereof I have caused the seal of the Commissioner of Patents to be hereunto affixed this twentieth day of November, 1883, and of the Independence of the United States the one hundred and eighth. Given under my hand at Washington, D. C.

The foregoing is a copy of the record, and attached hereto is a copy of said label.

(Signed) BENJ. BUTTERWORTH,
Commissioner of Patents.

(*Copy of Label.*)

WATERPROOF DRAWING INK

(Here follow photo-lithographs marked pp. 53, 54, 55, and 56, inclusive.)

57 EXHIBIT No. 6.

NEW YORK, *March* 6, 1884.

Mr. Charles M. Higgins, No. 5 Beekman St., city.

DEAR SIR: Referring to your last of February 23d, we have to inform you that Mr. Keuffel has returned. We have carefully considered the proposition contained in yours of Feb. 18th, and in reply would state that we will faithfully keep what our Mr. Keuffel has promised, but that we refuse to sign any agreement such as proposed by you.

We shall in future make up our photo-drawing ink in a different form of package.

Respectfully yours, KEUFFEL & ESSER.

No. 290
Higgins et al.
v.
Keuffel et al } p. 53

COMPLAINANTS' LABELS.

Exhibit No. 1.

WATERPROOF DRAWING INK.
Registered, 3693, 1883.
G. S. WOOLMAN, Agent, 116 Fulton St. N. Y.

"Exhibit Wrapper."

WATERPROOF.

Higgins' American India Inks.

(REGISTERED No. 2477. 1881.)

☞ This package contains one half-ounce bottle of

Waterproof Drawing Ink.

(REGISTERED No. 3693. 1883.)

NOTE.—We also make General Drawing Ink (red label), which is best for India ink tints and washes, for tracings, for Patent Office and photo drawings, and all fine line work. The Waterproof Drawing Ink (white lable) is insoluble when dry, and is best for working drawings which have to stand handling, moisture, or color washes. Select the kind which best suits your work.

CHAS. M. HIGGINS & CO., MANUFACTURERS,
NEW YORK AND BROOKLYN.

"Exhibit Box."

HIGGIN'S
AMERICAN INDIA INK.

Registered 2477. 1881.

Waterproof Drawing Ink

REGISTERED 3693. 1883.

Infringing Label from Exhibit No. 4.

(See also filed Exhibit).

This ink flows freely on any kind of paper and is always ready for use. It is the best ink for Mechanical and Architectural Drawings
WATERPROOF
BLACK
DRAWING INK
The lines drawn with this ink are perfectly indelible and will not be blurred or defaced by frequently applied brush lines.

No. 290.
Higgins et al.
v.
Keuffel et al. } p. 54.

Exhibit No. 5.

This ink flows freely on any kind of paper and is always ready for use. It is of a jet black color and specially prepared for making drawings to be reproduced by photographic process.
PHOTO
BLACK
DRAWING INK
This ink flows freely on any kind of paper and is always ready for use. It is of a jet black color and specially prepared for making drawings to be reproduced by photographic process

No. 290.
Higgins et al
v
Keuffel et al
p. 55

55

U. S. Circuit Court
Southern Dist. of N. Y.
In Equity
Keuffel et al
Complainants Exhibit No 9. Det. 27, 1886 J.J.S.

KEUFFEL & ESSER, NEW YORK. 193

LIQUID INDELIBLE DRAWING INK

No. 1160.

1160.	Liquid Indelible Drawing Ink, Black	each $	3[illegible]
1161.	" " " " Brown	"	40
1162.	" " " " Blue	"	40
1163.	" " " " Green	"	40
1164.	" " " " Scarlet	"	50
1165.	" " " " Carmine	"	50
1167.	Set of 1 bottle each of the above 6 Inks, in neat wooden box	"	2 25

These indelible drawing inks are a valuable addition to the draughtsman's outfit and specially adapted for mechanical drawing. The lines drawn with these colors are indelible and will not blurr or be defaced by frequently applied brush tints, nor by exposure in outdoor work.

No. 1168.

1168.	Liquid Photo-drawing Ink, deep black	each $	25
1169.	Higgin's Liquid Ink: General or Waterproof		25

No. 290.
Higgins et al.
v.
Keuffel et al. } p. 56.

N. J. Circuit Co.
Pltf's
Exhibit
in Equity
Higgins et al
vs
Keuffel et al
Complainants Exhibit
No. 9. Ex. 2/1/16 Dgs

KEUFFEL & ESSER CO. NEW YORK

LIQUID INDELIBLE DRAWING INK.

No. 1168, No. 1169. No. 1169 WP.

1160.	Liquid Indelible Drawing Ink, Bank	each $	25
1161.	" " " " Brown	"	40
1162.	" " " " Blue	"	40
1163.	" " " " Green	"	40
1164.	" " " " Scarlet	"	50
1165.	" " " " Carmine	"	50
1166.	" " " " Yellow	"	50
1167.	Set of 7 bottle each of 6 Inks, in neat wooden box	"	2 25

These indelible drawing inks are a valuable addition to the draughtsman's outfit and specially adapted for mechanical drawing. The lines drawn with these colors are, indelible and will not blurr nor be defaced by frequently applied brush hats, nor by exposure in outdoor work.

1168.	Liquid Photo-drawing Ink, deep black	each $	25
1168 WP.	Waterproof Drawing Ink	"	25

EXHIBIT No. 11.

(*Assignment.*)

In consideration of one dollar to me in hand paid by the firm of Charles M. Higgins & Co. I hereby sell, assign, transfer, and set over unto the said Chas. M. Higgins & Co. all my right, title, and interest in and to all claims and causes of action which I may now have or be entitled to against the firm of Keuffel & Esser and the individuals composing the said firm of Keuffel & Esser by reason of the infringement or unlawful use by that firm of my label, entitled "water-proof drawing ink," registered in the United States Patent Office, November 20th, 1883, No. 3693.

Dated New York, February 11, 1886.

[SEAL.] CHARLES M. HIGGINS.

57½ At a stated term of the circuit court of the United States of America for the southern district of New York, in the second circuit, held at the United States court-rooms, in the city of New York, on Saturday, the twelfth day of March, in the year of our Lord one thousand eight hundred and eighty-seven.

Present: The Honorable Hoyt H. Wheeler, judge.

CHARLES M. HIGGINS and JOHN GIANELLA *vs.* WILLIAM D. KEUFFEL and HERMANN ESSER. } In Equity. Feb. Term, 1887.

The above cause coming on this day for final hearing upon pleadings and proofs, Mr. Edward W. Cady is heard in behalf of complainants. Mr. Louis C. Raegener is heard in behalf of defendants. C. A. V.

58 United States Circuit Court, Southern District of New York.

CHARLES M. HIGGINS *et al.* *vs.* WILLIAM D. KEUFFEL *et al.* } In Equity. April Term, 1887.

This bill is brought upon a copyright of a label registered in the Patent Office by the orator Higgins October 27th, 1883, numbered 3693, act of June 18th, 1874, Suppl. Rev. Stat., 40; 18 Stat., 78. The title by which the label is registered is "water-proof drawing ink." The label itself consists of the same words in one line, in an oblong formed of double lines. The alleged infringement consists of the words "water-proof black drawing ink" in three lines in a similar oblong, with a medallion at each end of the lines of words within the oblong. No notice of a copyright by inscription on the labels is given otherwise than by the word and figures "Registered, 3693, 1883," printed on their face. The effect of this act of Con-
59 gress is understood to be to require the registration of labels in the Patent Office in place of their deposit in the office of

the Librarian of Congress to copyright them. Marsh *vs.* Warren, 18 Blatchf., 263. No remedy for infringement is given by that act, but the form of the notice, without which no action could be maintained, is so varied that it may be by the word "copyright," with the year in which and the person by whom the copyright was taken out instead of a statement of an entry in the office of the librarian as before was required. This would enable a notice of a copyright by registration to be given without the making of a false statement as to entry and make the statutes harmonious. The notice in one or the other of the forms was as much requisite to the maintaining of an action as before, and as much when the copyright was by registration in the Patent Office as when it was by deposit in the office of the librarian. If the word registered was the equivalent of the word copyright for this purpose the notice would lack
the name of the party by whom the copyright was
60 taken out. The name is expressly required to the notice by this act, as it has always been required in such notices of copyright—act of May 31st, 1790, Rev. Stat., sec. 4692—and the word copyright has a peculiar significance in such a notice. It carries the meaning of what has been done in a manner that the word registered alone does not. The former word signifies that the person whose name is appended had the right to copy, while the latter does not tell what had been registered nor where. The exact form of the notice is prescribed by law, and no equivalent is provided for nor any room for an equivalent left. If that specific notice is not given, the right of action otherwise conferred is withheld. All the requirements of law on which the right of action rests must be complied with or the suit cannot be maintained. Wheaton *vs.* Peters, 8 Pet., 591. This notice is so defective that the publication of the label with no other was the same in effect as a publication without any would have been. Such a publication is practically
an abandonment of the copyright. The orators claim that
61 Higgins was an inventor or discoverer of water-proof ink, for which he composed this label, and that to some extent the label indicated that ink to which it was applied was his. If these claims are well founded, as they may be, they do not appear to vary the rights of the orators as owners of this copyright. He has no patent for the ink, and the manufacture and sale of that appears to be open and free to all. This device was not registered as a trade-mark, and if the orators have any rights to it as such, growing out of its use, they are not in any manner involved here now. Trade-Mark Cases, 100 U. S., 82. The only right now involved is the exclusive right to copy, and no right of action upon that appears to remain.

These considerations make it unnecessary to consider any question of infringement.

Let there be a decree dismissing the bill of complaint, with costs.

(S'g'd) HOYT H. WHEELER.

Edward W. Cady, for orators; Louis C. Raegener, for defendants.

62 (Endorsed:) Circuit court of the United States for the southern district of New York. Charles M. Higgins *et al. vs.* William D. Keuffel *et al.* Decision, Wheeler, J.
(File-mark:) U. S. circuit court. Filed Apr. 19, 1887. Timothy Griffith, clerk.

63 At a stated term of the circuit court of the United States of America for the southern district of New York, held at the United States court-rooms, in the city of New York, on the 29th day of April, A. D. one thousand eight hundred and eighty-seven.
Present: Hon. Hoyt H. Wheeler, judge.

CHARLES M. HIGGINS and JOHN GIANELLA
against
WILLIAM D. KEUFFEL and HERMANN ESSER.

This cause having come regularly on for argument on complainants' pleadings and proofs and defendants' answer on the 12th day of March, 1887, in the presence of Edward Cady, Esq., of counsel for complainants, and Louis C. Raegener, Esq., of counsel for defendants, and, after hearing said counsel for complainants and defendants, a decision having been rendered and filed by his honor
64 Judge Wheeler in favor of defendants and in favor of dismissing said bill with costs, and thereafter the costs of defendants having been duly taxed at fifty-five dollars and twenty-seven cents—
Now, on motion of Goepel & Raegener, solicitors for said defendants, it is ordered that complainants' bill be, and the same hereby is, dismissed; and it is further ordered and adjudged that the defendants recover of complainants the said costs of fifty-five dollars and twenty-seven cents, and that they have execution therefor.
(Signed) HOYT H. WHEELER.

(Endorsed:) U. S. circuit court, southern district of N. Y. Charles M. Higgins & —— Gianella *vs.* William D. Keuffel & Hermann Esser. Final decree. Goepel & Raegener, solicitors for defendants.
(File-mark:) U. S. circuit court. Filed May 14, 1887. Timothy Griffith, clerk.

65 Circuit Court of the United States, Southern District of New York.

CHARLES M. HIGGINS and JOHN GIANELLA, Complainants and Appellants,
vs.
WILLIAM D. KEUFFEL and HERMAN ESSER, Defendants and Appellees.
} In Equity.

To the honorable the Supreme Court of the United States:
The appeal of Charles M. Higgins and John Gianella, the above-named complainants and appellants, respectfully showeth—
That on the 12th day of June, 1886, the above-named complain-

ants and appellants filed their bill of complaint in the circuit court of the United States for the southern district of New York against the above-named defendants and appellees to enjoin and restrain the said defendants and appellees from infringing a label
66 consisting of the words water-proof drawing ink, for which a certificate of registration was duly issued to the said Charles M. Higgins, one of the complainants and appellants aforesaid, by the Commissioner of Patents on the 20th day of November, 1883, and numbered 3693, and which was duly assigned, on or about May 1st, 1885, to the complainants and appellants in this action, and also praying for an account of profits and assessments of damages arising from said infringement.

That a subpœna issued out of said circuit court was duly served on the said defendants and appellees.

That the said defendants and appellees filed their answer to the said bill of complaint, to which the complainants and appellants filed a general replication.

Whereupon such proceedings were had in the cause that on the 14th day of May, 1887, a final decree was made and entered in said circuit court, wherein it was adjudged and decreed that the said bill of complaint be dismissed with costs; which said
67 judgment and decree is, as the complainants and appellants are advised, erroneous and ought to be reversed.

Wherefore these appellants appeal from the whole of said decree of said circuit court to the Supreme Court of the United States and respectfully pray that the decree of the said circuit court and the bill, answer, pleadings, depositions, evidence, exhibits, and proceedings in the said cause may be sent to the Supreme Court of the United States without delay, and that the said Supreme Court will proceed to hear the said cause anew, and that the said decree of the circuit court and every part thereof may be reversed or such other decree made as to the said Supreme Court shall seem just.

(S'g'd) CHARLES M. HIGGINS,
JOHN GIANELLA,
By their solicitor, EDWARD W. CADY.

(S'g'd) EDWARD W. CADY,
Solicitor and of Counsel for Complainants and Appellants.

68 (Endorsed:) U. S. circuit court, southern district of New York. Charles M. Higgins & *al. vs.* William D. Keuffel & *al.* Appeal. Edward W. Cady, solicitor for pl'ffs & appellants, 7 Beekman St., New York. Due service of a copy of the within appeal is hereby admitted. May 19, 1887. (S'g'd) Goepel & Raegener, sol'rs for def'ts.

Above appeal allowed.
(S'g'd) ADDISON BROWN.
New York, May 19th, '87.

(File-mark:) U. S. circuit court. Filed May 23, 1887. Timothy Griffith, clerk.

69 Circuit Court of the United States of America for the Southern District of New York, in the Second Circuit.

CHARLES M. HIGGINS and JOHN GIANELLA, Complainants and Appellants, *vs.* WILLIAM D. KEUFFEL and HERMAN ESSER, Defendants and Appellee. } Bond for Damages and Costs.

Know all men by these presents that we, George S. Woolman and Robert M. Curtiss, are held and firmly bound unto the above-named defendants in the sum of two hundred and fifty dollars, to be paid to the said defendants; for the payment of which, well and truly to be made, we bind ourselves and each of us, our and each of our heirs, executors, and administrators, jointly and severally, firmly by these presents.

Sealed with our seals and dated the eighteenth day of May, in the year of our Lord one thousand eight hundred and eighty-seven.

Whereas the above-named complainants have prosecuted this action to the Supreme Court of the United States to reverse the decision rendered in the above-entitled suit by the judge of the circuit court of the United States for the southern district of New York:

Now, therefore, the condition of this obligation is such that if the above-named appellants shall prosecute said appeal to effect and answer all damages and costs if said appellants fail to make their appeal good, then this obligation shall be void; otherwise the same shall be and remain in full force and virtue.

(S'g'd) GEORGE S. WOOLMAN.
(S'g'd) ROBERT M. CURTISS.

Sealed and delivered and taken and acknowledged this 18th day of May, 1887, before me—

[NOTARIAL SEAL.] GEO. M. BROOKS,
Notary Public, N. Y. Co.

70 [Endorsed:] Vol. —, page —. U. S. circuit court. Charles M. Higgins and John Gianella, complainants and appellants, *vs.* William D. Keuffel & Herman Esser, defendants and appellees. Bond for costs on appeal. Edward W. Cady, Temple Court, N. Y. city, proctor. Approved as to form and sufficiency. (S'g'd) Addison Brown. Filed this — day of ——, 18—. U. S. circuit court. Filed May 19, 1887. Timothy Griffith, clerk.

UNITED STATES OF AMERICA, *Southern District of New York*, } *ss.:*

GEORGE S. WOOLMAN, of No. 116 Fulton St., N. Y. city, and ROBERT M. CURTISS, of 101 Fulton St., N. Y. city, each separately and for himself, being duly sworn, deposes and says that he is worth the sum of five hundred dollars over and above all his just debts and liabilities.

(S'g'd) GEORGE S. WOOLMAN.
(S'g'd) ROBERT S. CURTISS.

Sworn to this 18th day of May, A. D. 1887, before me—

(S'g'd) GEO. M. BROOKS,
[NOTARIAL SEAL.] *Notary Public, N. Y. Co.*

71 By the Hon. Addison Brown, one of the judges of the circuit court of the United States for the southern district of New York.

UNITED STATES OF AMERICA, *Southern District of New York,* } ss:

To William D. Keuffel & Herman Esser and each of them, Greeting:

Whereas from the whole of the decree lately made by the circuit court of the United States for the southern district of New York, in a certain cause wherein Charles M. Higgins and John Gianella were complainants and William D. Keuffel and Herman Esser were defendants, the said complainants have appealed to the Supreme Court of the United States and have given good and sufficient security to prosecute their said appeal to effect and answer all damages and costs, therefore you are hereby cited and admonished to be and appear before the Supreme Court of the United States, at the city of
72 Washington, on the second Monday of October next, pursuant to said appeal, to show cause why the decree so appealed from as aforesaid should not be corrected and reversed and why speedy justice should not be done to the parties in that behalf.

Witness the Hon. Addison Brown, judge of the said circuit court, at the city of New York, on this 19th day of May, 1887.

(Signed) ADDISON BROWN.

(Endorsed:) U. S. circuit court, southern district of New York. Charles M. Higgins & John Gianella *vs.* William D. Keuffel & Herman Esser. Citation on appeal. Edward W. Cady, solicitor for appellants, 7 Beekman St., New York. Due service of a copy of the within citation is hereby admitted. May 19, 1887. (S'g'd) Goepel & Raegener, solicitors for William Keuffel & Herman Esser.

(File-mark:) U. S. circuit court. Filed May 23, 1887. Timothy Griffith, clerk.

73 Circuit Court of the United States for the Southern District of New York.

CHARLES M. HIGGINS and JOHN GIANELLA
vs.
WILLIAM D. KEUFFEL and HERMAN ESSER. } In Equity.

It is hereby stipulated that the foregoing may constitute the record in the above-entitled suit to be sent to the Supreme Court of the

United States by the clerk of this court on the appeal to said Supreme Court.

New York Sept. 17, 1887.

(S'g'd) EDWARD W. CADY.
Compl'ts' Sol'r.

(S'g'd) GOEPEL & RAEGENER,
Def'ts' Sol'rs.

(Endorsed:) U. S. C. C., S. D. N. Y. Higgins *vs.* Keuffel & *al.* Stipulation as to record. U. S. circuit court. Filed —— —, 1887. Timothy Griffith, clerk.

74 UNITED STATES OF AMERICA, *Southern District of New York,* } *ss:*

I, Timothy Griffith, clerk of the circuit court of the United States of America for the southern district of New York, in the second circuit, do hereby certify that the foregoing pages, numbered from one to seventy-three, inclusive, contain a true and complete transcript of the record and proceedings had in said court in the case of Charles M. Higgins and John Gianella against William D. Keuffel and Herman Esser as the same remain of record and on file in said office.

In testimony whereof I have caused the seal of the said court to be hereunto affixed, at the city of New York, in the southern district of New York, in the second circuit, this seventeenth day of September, in the year of our Lord one thousand eight hundred and eighty-seven, and of the Independence of the said United States the one hundred and twelfth.

Seal of U. S. Circuit Court, South. Dist. New York.

TIMOTHY GRIFFITH, *Clerk.*

Endorsed on cover: S. New York C. C. U. S. No. 290. Charles M. Higgins and John Gianella, appellants, *vs.* William D. Keuffel and Herman Esser. Filed October 31, 1887.

Office Supreme Court, U. S.
FILED.
MAR 31 1891
JAMES H. McKENNEY,

Supreme Court

OF THE UNITED STATES.

OCTOBER TERM. No. 990.

CHARLES M. HIGGINS and JOHN GIANELLA

against

WILLIAM D. KEUFFEL and HERMAN ESSER.

Appeal from the Circuit Court of the United States for the Southern District of New York.

BRIEF FOR APPELLANTS.

NEW YORK:
DOUGLAS TAYLOR, BOOK & LAW PRINTER, 89 NASSAU STREET, COR. FULTON.

1891.

Supreme Court of the United States,

OCTOBER TERM. No. 290.

CHARLES M. HIGGINS and JOHN GIANELLA

against

WILLIAM D. KEUFFEL and HERMAN ESSER.

Appeal from the Circuit Court of the United States for the Southern District of New York.

BRIEF FOR APPELLANTS.

This is a proceeding by appeal to review a decree of the Circuit Court of the United States for the Southern District of New York, dismissing a Bill in Equity, with costs, after hearing had, on pleadings, proofs and answer.

STATEMENT OF THE CASE.

Suit was brought by the appellants for an injunction to restrain the appellees from the use of a registered copyright label and for accounting and profits and damages.

The label was originated by Charles M. Higgins, of Brooklyn, New York, and was registered by him

under the United States Label Act of 1874 (Supp. R. S., Vol. 1., p. 40), a certificate of such registration having been issued to him on November 20, 1883, Number 3,693 (Exhibit No. 3, p. 30), and all rights thereunder have been assigned to the firm of Charles M. Higgins & Co., the appellants herein (Exhibit No. 11, p. 31).

It consists of an original combination of descriptive words, "Water-proof Drawing Ink", and was first used on bottles of liquid carbon or India ink, invented by Charles M. Higgins. This ink is insoluble, indelible, and proof against the action of water when dried on paper, pp. 49–51, pp. 28, 29; pp. 19–23, pp. 10–13; pp. 24–27, pp. 13–15.

(See p. 6 to 8 inclusive; also pp. 24, p. 13 to the end of pp. 26, p. 15.)

The label bore the words, "Registered 3693, 1883."

Higgins expended time, effort and money to perfect his inks, and he used thought, selection and judgment in composing his label, and his ink has become extensively known and sold, and has secured a large trade and reputation (pp. 19–22, pp. 10–12; (Answer 18), p. 13; p. 37, p. 21; pp. 43–45, pp. 24, 25.

The defendants first imitated the characteristic shape of bottle used by complainant without attempting to copy their label (pp. 27–29 inclusive, pp. 15, 16; answer 61, p. 31, p. 18 Exhibit No. 7). They used on these counterfeit bottles labels entitled "Indelible Drawing Ink", meaning by the word "Indelible" the same quality (water-resisting) as indicated on Higgins' label by the word "Water-proof". (Exhibit No. 7). On remonstrance from Higgins, the defendants gave up that shape of bottle (pp. 17, 18; Exhibit No. 6, p. 30). Higgins also cautioned the defendants at this time to avoid using his label "Water-proof Drawing Ink" on their new bottles, and they agreed to respect that label and not to infringe it (pp. 47, 48).

The defendants admitted at the trial that they had sold ink, bottled and labeled as Exhibit No. 4, which embodies the infringement complained of. (pp. 27, pp. 15 and 54).

Defendants' answer was a general denial, and a plea that defendants' label was unlike the label of complainants, and that the complainants' label was not matter for registration as a label, because the label is descriptive, and describes the quality and attributes of the ink.

The Court below decided that the words Registered 3693, 1883, were not sufficient notice that the label was registered.

SPECIFICATIONS OF ERRORS RELIED UPON.

The appellant specifies the following errors in the decree:

1st. It was error for the Court to hold in the decree that the complainants' bill should be dismissed.

2d. It was error for the Court to refuse to hold that the complainants' in the Court below were entitled to an injunction and an accounting.

3d. It was error for the Court below to hold that the notice of the fact that the label had been registered was defective.

4th. It was error for the Court below to hold that the complainants' label was not protected by the law of copyright.

5th. It was error for the Court below to hold that no right of action exists to maintain an exclusive right to copy the label on part of the complainants.

I.

Labels for articles of merchandise are protected by the copyright law.

This is distinctly provided for by statute.

Act of June 18, 1874, Supp. R. S., Vol. 1, page 40, Secs. 3, 4, and 5.

In those sections it is provided that no prints or labels designed or to be used for any other articles of manufacture than pictures or works of art, shall be entered under the copyright law, but it provides that they may be registered in the Patent Office. And the act provides that the Commissioner of Patents is charged with the supervision or control of the registry of such prints or labels, in conformity with the regulations provided by law as to copyright prints.

Even under the Act of 1870 it was held that a label was a subject of copyright.

Blackwell *vs.* Armisted, 3 Hughes, 163.

II.

The descriptive name of the labeled article may form a valid label.

It does in this case, because there is an exercise of ingenuity, taste, judgment and selection in the construction of the name.

It is as much a matter of literary composition as it would be if it were a book. The length of the composition does not affect the question.

Held, that a book might be printed on only one sheet and be protected by the statute.

Clayton *vs.* Stone, 2 Paine, 382.

So a blank form may be protected.

Brightley *vs.* Littleton, 37 F. R., 103.

So a chart showing a diagram representing a system for taking measurements for garments may be protected.

Drury *vs.* Ewing, 1 Bond, p. 540.

And so may this brief but vivid and apposite description of the character and merits of the commodity sold by the complainants.

III.

Slight difference between label registered and label used, not material.

The label now used on complainants' goods (Exhibit No. 1, &c.) is a little different in size and style of typography from that deposited for registration (see Exhibit No. 3), but these differences are mere typographical changes, such as may exist in two or more editions of a copyrighted work, and do not affect the essentials of the copyright, which are *verbal construction* or *combination*, and not *typographical form*.

IV.

The label in this case was duly marked.

It was on the alleged absence of notice on the label that complainant was defeated.

Section 4962 of the Revised Statutes, relating to

copyrights for works of art, directs specifically how they are to be marked with the notice of copyright, such as: "Entered according to Act of Congress, in the year , by A. B., in the office of the Librarian of Congress, at Washington," or as "Copyright 18., by A. B." Now, in the provisions relating to labels (Act June 18, 1874, Supp. R. S., Secs. 3, 4, 5, Vol. 1 p. 40), there are no directions as to how labels registered in the Patent Office are to be marked with the notice of registry or copyright. It would not do to mark them as directed in Sec. 4962, as this relates to copyrights for works of art, and to things which are registered with the Librarian of Congress (See Complainants' Record, p. 39). As the law gave no direction as to this, it has been assumed that any proper marking, which gave notice of the fact that the label was copyrighted and of the date of registry, was sufficient. The complainants marked their label (Exhibit 1) published in the Official Gazette, U. S. Patent Office, as follows: "Registered 3693–1883," giving the number and the year of registry. Besides this, it is proved that defendants had ample notice of the copyright (p. 27).

There was no method of indicating registry, directed by law, because the Commissioner of Patents had established no regulations on that subject.

V.

Law of registration duly complied with.

The law was fully complied with in the application for, and the issue of the certificate of registration. The section of the R. S., 4959, directing the deposit with the Librarian of Congress within ten

days after publication, of two copies of the copyrighted article, does not apply to labels, but to works of art, and all that is necesssary for valid label registration is to deposit the labels with the Commissioner of Patents at the outset, and the title to the copyright in the label is perfected when said certificate of registration is issued by the Commissioner of Patents, and when the registrant subsequently published or uses the registered labels on his goods.

VI.

The judgment below should be reversed for the reasons assigned.

CHAS. B. ALEXANDER,
Solicitor and of Counsel for the Appellant.

FILED.
MAR 30 1891
JAMES H. McKENNEY
CLERK

SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1890.

No. 290.

CHARLES M. HIGGINS AND JOHN GIANELLA,
Appellants,

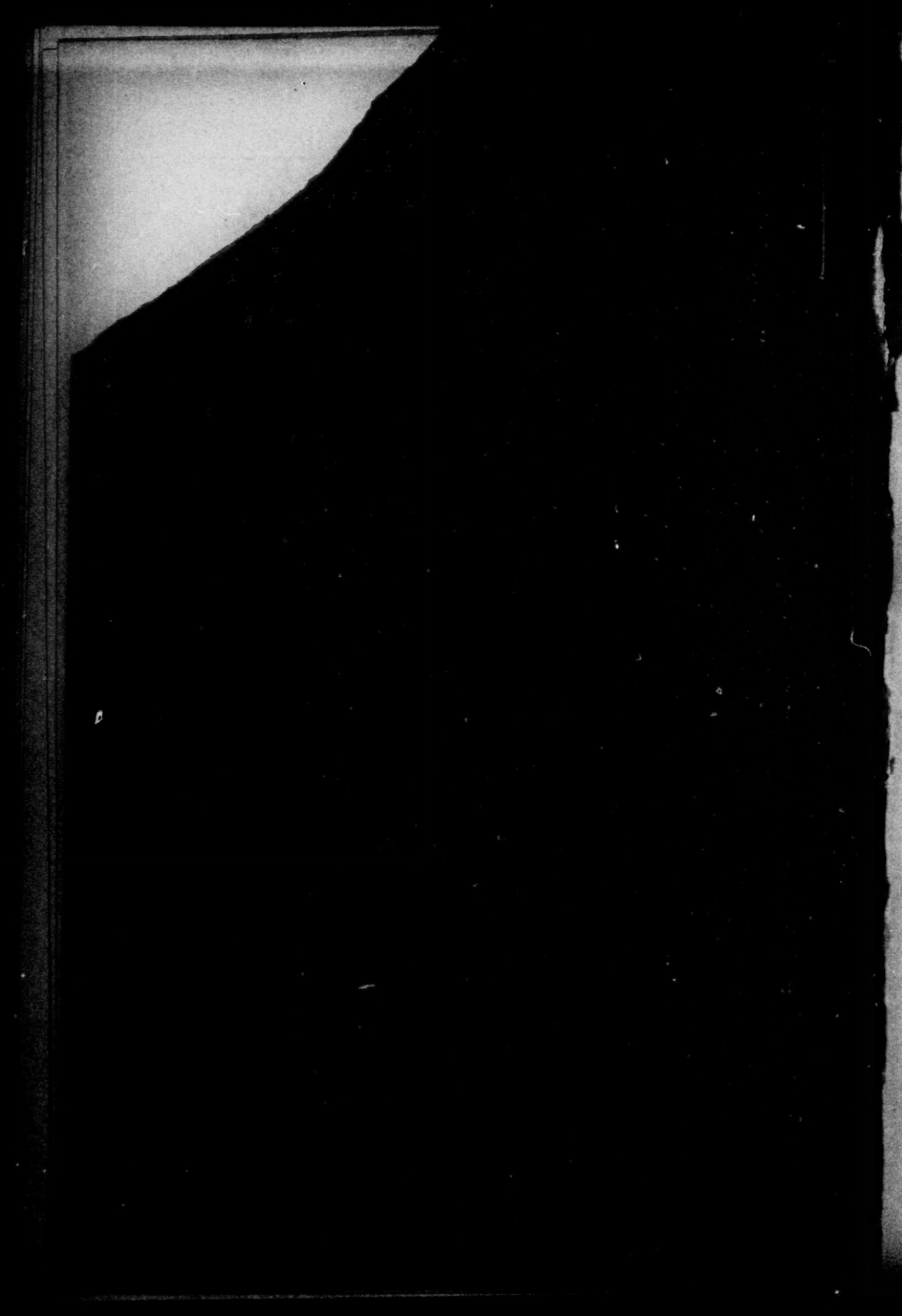
vs.

WILLIAM D. KEUFFEL AND HERMAN ESSER.

BRIEF FOR APPELLANTS.

WILLIAM A. REDDING,
Counsel for Appellants.

C. G. Burgoyne, 146-150 Centre Street, N. Y.



SUPREME COURT OF THE UNITED STATES.

CHARLES M. HIGGINS and JOHN GIANELLA,
Appellants,

vs.

WILLIAM D. KEUFFEL and HERMAN ESSER,
Appellees.

No. 290.
October Term
1890.

Statement of the Case.

This is an appeal from the Circuit Court of the United States for the Southern District of New York, by Charles M. Higgins and John Gianella, who were complainants below, and against whom the said Court entered a decree in equity dismissing the bill of complaint they brought against William D. Keuffel and Herman Esser, appellees, who were defendants below. The bill was brought against the appellees for an injunction to restrain them from using appellants' registered label, "Waterproof Drawing Ink," and to recover from them damages and profits for their infringement upon this registered label.

The bill contains the usual and necessary averments and prayer; an answer was filed by appellees setting

up defenses which will be referred to presently; and a replication was filed.

Proofs were taken on behalf of appellants in support of the averments contained in the bill, but no proofs were taken on behalf of appellees.

The facts established by the proofs of appellants and covered by the averments in the bill are as follows:

Charles M. Higgins, one of the appellants, invented and was the first to produce, put upon the market and sell a liquid drawing ink having the quality of being insoluble and waterproof when dried (Record, pp. 10, 11, 13, 14 and 29).

He composed and adopted the phrase or collocation of words "Waterproof Drawing Ink" as a name or title for a label for this ink and was the first to apply the term "waterproof" to an ink and to combine, adopt and use the words "Waterproof Drawing Ink" for an ink (Record pp. 12, 14 and 28).

He entered and registered this name or title "Waterproof Drawing Ink" for a label, in the United States Patent Office, October 27th, 1883, under the provisions of the Act of Congress of June 18th, 1874 (Supplement Rev. Stat., 40; 18 Stat., 78); and the Commissioner of Patents issued to him a certificate of registration therefor, dated November 20th, 1883, and numbered 3693 (Record pp. 12, 13 and 30).

He entered and registered in the United States Patent Office this name or title for a label, and the certificate of registration therefor was issued to him before the label was used or published (Record, p. 13).

About May 1st, 1885, he granted to the firm of Charles M. Higgins & Co., composed of the appellants, the exclusive right and license to use this registered label for the term of five years from that date; and about February 11th, 1886, he assigned to this firm all claims and causes of action against the appellees for infringement upon this registered label (Record, pp. 10, 20 and 31).

Since the registration of this label the appellants have extensively sold their waterproof drawing ink under and by this registered label throughout the United States. This label has been affixed to each bottle of the ink; it has also been printed in a conspicuous place on each wrapper containing a bottle of the ink, and it has also been printed in a prominent place on each wooden box in which the wrapped bottles of the ink have been packed for the trade. The appellant's waterproof drawing ink has thus become widely and favorably known throughout the United States under and by this registered label (Record, p. 13).

This registered label as used by the appellants in each instance has had printed thereon the notice "Registered 3693, 1883," because this form of notice was generally used on labels registered under the Act of June 18th, 1874, and believed to be the correct and proper form. The appellants did not print on this registered label the notice "Entered according to Act of Congress in the year 1883 by Charles M. Higgins in the office of the Librarian of Congress at Washington," or the notice "Copyright, 1883, by Charles M. Higgins," because they thought neither of these two forms of notice could be applied to or used in connection with a label registered in the United States Patent Office under the Act of Congress of June 18th, 1874 (Record, p. 24 and opposite p. 30).

The appellees first imitated the shape of the bottles in which the waterproof drawing ink of the appellants was sold, and used labels on these bottles, each containing the words "Indelible Drawing Ink." Appellants remonstrated against this imitation of the shape of their bottle by the appellees, whereupon the appellees changed the shape of their bottle, but at the same time abandoned their label "Indelible Drawing Ink," and deliberately used the appellants' registered label, "Waterproof Drawing Ink," for the purpose of obtaining the advantage and benefit of the excellent reputa-

tion established by appellants for their ink under and by this registered label (Record, pp. 15, 16, 17, 18, 19, 26 and 30).

The appellees having taken no proofs, relied upon their answer, which sets up defenses as follows:

1. Registration of the label "Waterproof Drawing Ink" is void and of no effect in law, because the label is descriptive and describes the quality and attributes of the ink.
2. Registration of the words "Waterproof Drawing Ink" as a label is void and of no effect in law, because these words are not proper subject matter for registration in the Patent Office as a label and cannot lawfully form and be a good and valid label.
3. Non-infringement.

Record, pp. 7 and 8.

In addition to these defenses, the appellees, at the hearing of the case in the Court below, presented defenses not set up in their answer, as follows:

1. Right of action cannot be maintained because the registered label was used by appellants without the notice "Entered according to Act of Congress in the year 1883 by Charles M. Higgins in the office of the Librarian of Congress" or the notice "Copyright 1883 by Charles M. Higgins."
2. Congress never intended to have the Copyright law applied to labels.
3. Congress has not the power to enact any law authorizing the copyrighting of labels.

Decree and Opinion of Court Below.

The case was heard in the Court below upon the pleadings and the proofs taken on behalf of the appellants, and a decree in the usual form was entered by

the Court below against the appellants dismissing the bill of complaint with costs (Record, p. 33); and in support of the decree an opinion was filed as follows (Record, p. 31, and 30 Federal Rep., 627):

WHEELER, J.:

This bill is brought upon a copyright of a label registered in the Patent Office by the orator Higgins, October 27, 1883, numbered 3693. Act of June 18, 1874 (Sup. Rev. St., 40; 18 St., 78). The title by which the label is registered is "Waterproof Drawing Ink." The label itself consists of the same words, in one line, in an oblong formed of double lines. The alleged infringement consists of the words "Waterproof Black Drawing Ink," in three lines, in a similar oblong, with a medallion at each end of the lines of words within the oblong. No notice of a copyright by inscription on the labels is given otherwise than by the word and figures "Registered, 3693, 1883," printed on their face. The effect of this Act of Congress is understood to be to require the registration of labels in the Patent Office, in place of their deposit in the office of the Librarian of Congress, to copyright them (Marsh vs. Warren, 14 Blatchf., 263). No remedy for infringement is given by that act; but the form of the notice, without which no action could be maintained, is so varied that it may be by the word "copyright," with the year in which, and the person by whom, the copyright was taken out, instead of a statement of an entry in the office of the Librarian, as before was required. This would enable a notice of a copyright by registration to be given without the making of a false statement as to entry, and make the statutes harmonious. The notice, in one or the other of the forms, was as much requisite to the maintaining of an action as before, and as much when the copyright was by registration in the Patent Office as when it was by deposit in

the office of the Librarian. If the word "registered" was the equivalent of the word "copyright," for this purpose, the notice would lack the name of the party by whom the copyright was taken out. The name is expressly required to the notice by this act, as it has always been required in such notices of copyright (Act May 31, 1790; Rev. St., Sec. 4962). And the word "copyright" has a peculiar significance in such a notice. It carries the meaning of what has been done in a manner that the word "registered" alone does not. The former word signifies that the person whose name is appended had the right to copy, while the latter does not tell what had been registered nor where. The exact form of the notice is prescribed by law, and no equivalent is provided for nor any room for an equivalent left. If that specific notice is not given the right of action otherwise conferred is withheld. All the requirements of law on which the right of action rests must be complied with or the suit cannot be maintained (Wheaton vs. Peters, 8 Pet., 591). This notice is so defective that the publication of the label with no other was the same in effect as the publication without any would have been. Such a publication is practically an abandonment of the copyright. The orators claim that Higgins was an inventor or discoverer of waterproof ink for which he composed this label, and that to some extent the label indicated that ink to which it was applied was his. If these claims are well founded, as they may be, they do not appear to vary the rights of the orators as owners of this copyright. He has no patent for the ink, and the manufacture and sale of that appears to be open and free to all. This device was not registered as a trade-mark; and if the orators have any rights to it as such growing out of its use they are not in any manner involved here now (Trade-mark Cases, 100 U. S., 82). The only right now involved is the exclusive right to copy, and no right of action upon that appears to remain.

These considerations make it unnecessary to consider any question of infringement.

Let there be a decree dismissing the bill of complaint with costs.

Assignment of Errors.

I. The Court below erred in the following *findings of law* contained in the opinion of the Court:

FIRST. That the notice, "Registered, 3693, 1883," printed on the face of the registered label of appellants, is a defective notice, and the publication of this label with no other notice was the same, in effect, as a publication without any notice and is practically an abandonment of the copyright.

SECOND. That the appellants, having published their registered label without any notice printed thereon other than the word and figures "Registered 3693, 1883," cannot maintain their action against the appellees for the infringement of said registered label.

THIRD. That the appellants, having published their registered label with the notice "Registered 3693, 1883," printed on the face thereof, cannot maintain their action against the appellees for the infringement of said registered label because of the omission from the notice of the name of the party by whom the label was registered.

FOURTH. That the word "registered" as used by the appellants in the notice printed upon the face of their registered label is not an equivalent of the word "Copyright" for the purpose of such notice.

FIFTH. That a specific form of notice is required to be given on a label registered in the United States Patent Office under the Act of Congress of June 18, 1874.

SIXTH. That the appellants cannot maintain their action against the appellees for the infringement of the registered label, because the appellants published this

label without any notice printed thereon in either of the following forms: "Copyright 1883 by Charles M. Higgins," or, "Entered according to Act of Congress in the year 1883 by Charles M. Higgins in the office of the Librarian of Congress at Washington," or, "Entered according to Act of Congress in the year 1883 by Charles M. Higgins in the Patent Office at Washington."

SEVENTH. That the appellants have no right of action against the appellees for the infringement of their registered label.

II. The Court below erred in dismissing the bill because the appellants had the right to maintain their action against the appellees for the infringement of their registered label.

III. The Court erred in entering a decree against the appellants dismissing their bill.

ARGUMENT.

I.

The appellants having published and used their registered label with the notice, "Registered 3693, 1883," printed on the face thereof, can they maintain an action for the infringement of this label?

This is the principal and most important question arising on this appeal. To properly consider this question it is necessary to critically examine the Act of

Congress of June 18, 1874 (Supplement Rev. Stat., 40; 18 Stat. At Large, 78).

The first section of this act is as follows:

> "No person shall maintain an action for the infringement of his copyright, unless he shall give notice thereof by inserting in the several copies of every edition published, on the title page or the page immediately following, if it be a book; or, if a map, chart, musical composition, print, cut, engraving, photograph, painting, drawing, chromo, statue, statuary, or model or design intended to be perfected and completed as a work of the fine arts, by inscribing upon some visible portion thereof, or of the substance on which the same shall be mounted, the following words, viz.:
>
> "*Entered according to Act of Congress in the year , by A. B., in the Office of the Librarian of Congress, at Washington;*" *or, at his option the word* "*Copyright,*" *together with the year the copyright was entered, and the name of the party by whom it was taken out; thus:* "*Copyright, 18—, by A. B.*"

It will be observed that this first section of the act prescribed several distinct and specific requisites to enable the owner of a copyright to maintain an action for the infringment thereof, to wit:

1. It prescribes a specific form of notice in these words:

(a) "Entered according to the Act of Congress, in the year , by A. B., in the office of the Librarian of Congress, at Washington;" or,

(b) "Copyright, 18 , by A. B."

2. It prescribes a particular place where either of these two forms of notice shall be inserted in a copyrighted book, viz:

(a) On the title page of the book ; or,
(b) On the page immediately following the title page of the book.

3. It prescribes a particular place where either of these two forms of notice shall be inscribed on a copyrighted map, chart, musical composition, print, cut, engraving, photograph, painting, drawing, chromo, statue, statuary or model or design intended to be perfected and completed as a work of the fine arts, viz :

(a) On some visible portion thereof ; or,
(b) On some visible portion of the substance on which the same shall be mounted.

Is a label registered in the Patent Office under the provisions of this Act of June 18, 1874, included within the terms of this first section of the act ? The only words in this section which could be applied to a label are the words "print," "cut" and "engraving." If a label registered in the Patent Office under this act is included within the terms of this section of the act under the words "print," "cut" and "engraving," then it is clear the appellants cannot maintain the action against the appellees for the infringement of their registered label, because the appellants published and used their label without either of the precise forms of notice prescribed by this section of the act.

It is contended, however, on behalf of appellants that a label registered in the Patent Office under the provisions of this act is not within the terms of the first section of the act, and, therefore, they can maintain the action for the infringement of their registered label notwithstanding the fact it was published and used by them without either of the precise forms of notice prescribed by the first section of the act.

Labels registered in the Patent Office under this act are expressly excluded from the terms of the first sec-

tion of the act by the language of the third section of the act which reads as follows:

> "In the construction of this act the words 'engraving,' 'cut' and 'print' shall be applied only to pictorial illustrations or works connected with the fine arts.
>
> "And no prints or labels designed to be used for any other article of manufacture shall be entered under the copyright law, but may be registered in the Patent Office. And the Commissioner of Patents is hereby charged with the supervision and control of the entry or registry of such prints or labels in conformity with the regulations provided by law as to copyright of prints, except that there shall be paid for recording the title of any print or label not a trade-mark, six dollars, which shall cover the expense of furnishing a copy of the record under the seal of the Commissioner of Patents to the party entering the same."

There are three important provisions in the third section of the act to be carefully considered, viz.:

I. It provides that *this act* shall be construed so that the words "engraving," "cut" and "print" shall be applied only to pictorial illustrations or works connected with the fine arts. As these words are to be applied only to pictorial illustrations or works connected with the fine arts, they cannot be applied to labels designed to be used for any article of manufacture and registered in the Patent Office. Therefore the third section of the act, by providing that the words "engraving," "cut" and "print" shall be applied only to pictorial illustrations or works connected with the fine arts, takes out of the first section of this act labels registered in the Patent Office, and, consequently, it is not necessary to inscribe on such labels either of the

precise forms of notice prescribed by the first section of this act.

II. It next provides that no prints or labels designed to be used for any article of manufacture shall be entered under the copyright law, but may be registered in the Patent Office. What is the meaning of this language? It certainly does not mean that such prints or labels shall not have the same protection as copyrights, or that such prints or labels are not within the copyright law. The language is, such prints or labels shall not be *entered* under the copyright law; that is to say, they shall not be entered where other copyrights are entered, viz., in the office of the Librarian of Congress but that they may be *registered* in the Patent Office. The effect of this language is merely to change the place of entering or registering such prints or labels and not to change the character of the property or affect the rights of the parties registering the prints or labels. Indeed, it may be fairly said that the third section of the act classifies copyrights by placing books, pictorial illustrations and works connected with the fine arts in one class and prints and labels designed to be used for articles of manufacture in another class, and provides for the entry and registration of the copyrights of the second class in the Patent Office, while the copyrights of the first class are entered in the office of the Librarian of Congress under the old law.

III. It next provides that the entry or registry in the Patent Office of prints or labels designed to be used for any article of manufacture shall be under the supervision and control of the Commissioner of Patents in conformity with the regulations provided by law as to copyright of prints. It is to be particularly noted that it is the *entry or registry* which is to be under the supervision and control of the Commissioner of Patents, and that it is the *entry or registry* which is to be in con-

formity with the regulations provided by law as to copyright of prints.

There is not a sentence or any language in this Act of June 18, 1874, which can be fairly construed so as to include within the terms of the first section of the act prints or labels registered in the Patent Office. But, on the contrary, both the letter and spirit of the first section of the act invite the conclusion that its provisions are to apply only to such copyrights as are entered in the office of the Librarian of Congress. One of the forms of notice prescribed by the first section of the act contains the statement that the copyright is *entered in the office of the Librarian of Congress.* It is fair to assume that the third section of the act provides that the words "engraving," "cut" and "print" shall be applied only to pictorial illustrations or works connected with the fine arts, so as to purposely exclude from the provisions of the first section of the act all prints and labels registered in the Patent Office, because both the letter and spirit of the first section of the act indicate that its provisions shall apply only to copyrights entered in the office of the Librarian of Congress.

The first section of the act is of a penal character. It imposes the penalty of taking away from the owner of a copyright the right to maintain an action for an infringement thereof where the copyright has been published without either of the precise forms of notice prescribed by the first section of the act. Therefore, it should be construed strictly. How is it possible to construe it strictly and at the same time include within its terms labels registered in the Patent Office? It provides that the copyright shall be marked with either of the precise forms of notice prescribed therein; or, in other words, the owner of a copyright may exercise an option and use either of these prescribed forms of notice. Conse-

quently, if the appellants had inscribed upon some visible portion of their registered label the notice, "Entered according to the Act of Congress in the year 1883, by Charles M. Higgins, in the office of the Librarian of Congress at Washington," the notice would have been in the form prescribed by the first section of the act; but this notice, in such case, would have been inconsistent; it would have been misleading, and it would have been untrue. Yet, if their registered label is within the terms of the first section of the act they would have had the right to have used the notice in this form. To give this section a broad and liberal construction, for the purpose of having its provisions apply to labels registered in the Patent Office, would result in great injustice to the appellants by depriving them of property which has been made very valuable by the expenditure of a large amount of money. Indeed, it would result in great injustice to many parties who have registered labels in the Patent Office and published them with a notice similar to that used by the appellants. Previous to the decision of the Court below it was the general custom to mark registered labels with a notice similar to that used by the appellants, because it was the general opinion that the form of notice prescribed by the first section of the act could not lawfully or properly be applied to a label registered in the Patent Office.

The form of notice "Registered, 3693, 1883," used by the appellants on their registered label is a more appropriate and much better form of notice for a registered label than either of the forms prescribed by the first section of the act, because it states the number of the registration of the label and the year in which it was registered, and as the registration of labels in the Patent Office is published each week in the "Official Gazette" of the Patent Office, full information concerning the registration can be readily and easily obtained. There is this important difference between a registered

label and other copyrights : The registration of labels in the Patent Office is published each week in the "Official Gazette" in the Patent Office so that the public may have notice thereof, but the entry of copyrights in the office of the Librarian of Congress is not published, and the only notice the public can have thereof is the notice required to be marked thereon under the provisions of the first section of the act.

The appellees, before they began to use or infringe upon the registered label of the appellants, were personally notified of the registration of the label of the appellants and cautioned not to infringe upon said label, so that the appellees were not only notified by the notice printed upon the labels, but were personally notified of the registration of this label before they began to use it (Record, pp. 17, 27 and 30).

II.

Are the words "Waterproof Drawing Ink" proper subject matter for registration as a label under the copyright law.

This question arises upon the issue framed by the pleadings and was fully discussed in the argument of the case in the Court below, but was not considered by the Court below, because the decree was entered dismissing the bill on the sole ground that the appellants could not maintain the action by reason of having published the label without the form of notice prescribed by the First Section of the Act of June 18, 1874.

Before considering this question it is proper to inquire what is a label. A very clear and excellent definition of a label is given in Commissioner Butter-

worth's opinion in *Ex parte* Moodie as follows (Official Gazette, Vol. 28, page 1272):

> "The distinctive feature of a label is that it is descriptive. It tells one the contents of the package to which it is affixed. It is composed of words in ordinary use, used with their ordinary significance. It is such a placard as might be written by any one who had such goods to sell, irrespective of their origin. The protection afforded by the statute is similar to that of a copyright. It covers the arrangement and dress of the subject matter, not the subject matter itself. Anybody else may take the same ideas and dress them up in another way and protect that arrangement by copyright or registration."

A label must be descriptive. The purpose for which it is intended to be used indicates that it must have this quality. Its very name also indicates that it must be descriptive. In this respect it differs from a trademark which must not be descriptive of the article to which it is applied.

The essential feature of a label is its verbal composition or phraseology. This verbal composition or phraseology involves literary construction and judgment. A descriptive name or title for a label may be composed and selected with considerable literary judgment and taste, so as to be of great value by commanding attention, attracting custom, inducing confidence and establishing a reputation for the article to which the label is applied. When, therefore, a manufacturer composes a name for his goods by selecting out of the language a combination of properly descriptive words signifying the nature or quality of his goods in preference to a number of other similar words that might be selected for the same purpose, he thus exercises verbal or literary choice, taste or judgment and

when the selected combination of purely descriptive words is new, forming a new trade name or title for his goods and which gives his goods character and distinction, he can with propriety and justice claim protection under the copyright law for the label bearing the selected combination of descriptive words, for it is the essential purpose of the copyright law to protect new verbal combinations involving more or less literary judgment or taste.

A single descriptive word is not proper subject matter for registration as a label under the copyright law. It must be a label composed of a selected combination of descriptive words forming a complete phrase, name or title giving a distinct idea of the nature or quality of the article for which the label is designed to be used.

The name and address of the manufacturer is not proper subject matter for registration as a label under the copyright law. The adoption and use of the name and address of the manufacturer involves no choice or selection of words and involves no exercise of any literary taste or judgment and involves no composition or combination of words. In such case the name and address constitute words of a fixed, unalterable and unavoidable character. It would be analogous to the adoption and use of a fanciful, arbitrary or symbolic word which cannot constitute a valid registered label. The name of the manufacturer, as likewise a fanciful, arbitrary or symbolic word, constitutes a valid trade-mark deriving adequate protection under the common law, and is not proper subject matter for registration as a label and is not entitled to protection under the copyright law.

A label being descriptive of the article for which it is designed to be used cannot be a valid trade-mark and receives no protection whatever at common law. It is protected only by the copyright law.

The quality and quantity of literary composition are not necessary elements to constitute a label

which may be registered under the copyright law. It is obvious that a label cannot exhibit the amount of literary composition and taste which is exhibited by a book or poem, and it is not expected to do so. A composer of a label, like an author of a book, cannot use any more composition than is demanded by his subject. Literary novelty and merit may exist in a few words as well as in a book. Many men have become famous by a mere phrase. A label, by reason of its character, permits of the selection of only a few words. The combination and selection of a few words to form or compose a phrase may exhibit the highest kind of literary taste and skill. Illustrations of how literary taste and judgment may be exercised in the combination and selection of words to compose a title for a label, may be referred to as follows: A manufacturer of a double-face carpet might select any one of a number of combinations of words to properly describe the character of this carpet, as for instance, "Reversible Carpet," "Double-Pile Carpet," "Two-sided Carpet," "Duplex Carpet," "Turnable Carpet" or "Double-face Carpet." And a manufacturer of a non-decaying paste might select any one of a number of combinations of words to properly describe the character of the paste, as for instance, "Permanent Paste," "Enduring Paste," "Undecaying Paste," "Non-decaying Paste," "Antiseptic Paste," "Non-offensive Paste" or "Imperishable Paste."

If the combined words composing the title of a label are the only words which can be selected and combined to describe the article for which the label is designed to be used, then, of course, no exclusive right can be obtained under the copyright law for such a label, as, for instance, if the combined words, "double face carpet" were the only words in the language describing a carpet of this character, then this combination of words would not be within the protection of the copyright law.

Where, however, there is an opportunity to make a selection and combination from a number of different words adapted to express the same idea, the manufacturer can exercise literary taste and judgment in making the selection and combination from these words to compose an attractive phrase or title for a label to be protected under the copyright law.

This is exactly what Charles M. Higgins, one of the appellants did, when he selected and combined the words, "Waterproof Drawing Ink," as a title for the label to be used upon the liquid drawing ink invented and first produced and put upon the market by him. These words are not the only words adapted to express the idea expressed by them and are not the only words adapted to describe a liquid drawing ink having the quality of being insoluble and waterproof when dried, as, for instance, any one of the following mentioned combination of words might be used for that purpose: "Washable Drawing Ink," "Indelible Drawing Ink," "Insoluble Drawing Ink," "Fixed Drawing Ink" or "Fast Drawing Ink."

III.

Is a label proper subject matter for protection under the copyright law?

As a label is descriptive of the article for which it is designed to be used it cannot be a trade-mark, and consequently is in no way protected by the common law. If it is not protected by the copyright law it is not protected at all, although it is worthy of as much protection as a trademark.

Prior to the enactment of the Act of Congress of

June 18, 1874, labels designed to be used for any article of manufacture were entered or registered in the office of the Librarian of Congress under the provisions of the copyright law, as it was held they were included under the term "print" used in the statute relating to the entry and registry of copyrights.

United States vs. Sewing Machine Co., 1 Mackey, 291.
Marsh vs. Warren, 14 Blatch., 264.
The Durham Smoking Tobacco Case, 3 Hughes, 170.

The Act of June 18, 1874, in the third section thereof, expressly provides for the protection of such labels under the copyright law in this language (Sup. Rev. Stat., 40; 18 Stat. at L. 78).

> "No prints or labels designed to be used for any other article of manufacture shall be entered under the copyright law, but may be registered in the Patent Office. And the Commissioner of Patents is hereby charged with the supervision and control of the entry or registry of such prints or labels in conformity with the regulations provided by law as to copyright of prints."

The proper interpretation of this language as has been shown in a previous part of this argument is that it provides only for a change of the place where labels are to be entered or registered, that is to say, it changes the place from the office of the Librarian of Congress to the Patent Office. The language is, that no such prints or labels "shall be *entered* under the copyright law, but may be *registered* in the Patent Office." This does not mean that such prints or labels shall not be protected by the copyright law. It only means that they shall not be *entered* in the place where other copyrights are entered. If this were not the correct interpretation, why would this language be followed by the provision that the Commissioner of Patents is charged

with the supervision and control of the entry or registry of such prints or labels in conformity with the regulations provided by law as to copyright of prints ?

Here is an express recognition of the fact that previous to the enactment of the statute, labels were included in the term "print," as used in the copyright law, and, therefore, were protected under the provisions of the copyright law.

It is therefore obvious that labels are proper subject matter for protection under the copyright law, and that the statutes relating to copyrights expressly provide for the protection of labels. Indeed, it has been held by the courts a number of times that labels of this character are protected by statutes relating to copyrights.

United States vs. Sewing Machine Co., 1 Mackey, 290.
Marsh vs. Warren, 14 Blatch., 264.
The Durham Smoking Tobacco Case, 3 Hughes, 170.

It may be argued by counsel for appellees that Congress has no constitutional power to enact a statute for the protection of labels designed to be used for an article of manufacture, but such an argument cannot prevail when a label is defined and its character is understood. A label is certainly as much a product of intellectual labor as a simple catalogue which is copyrightable under the term " book." The selection of a combination of words to form and compose an attractive phrase or title for a label may require the exercise of as much literary taste and judgment as is required to arrange and produce a catalogue or pamphlet which are copyrightable under the term " book." The matter to be copyrighted must be original and possess some possible utility. The originality, however, may be of the lowest order, and the utility barely perceptible. Consequently the statute relating to copyrights has been so liberally construed that it is held to embrace

within the term "book" every character of publication; whether a volume, pamphlet, newspaper article, calendar or catalogue.

Brightley vs. Littleton, 37 Fed. Rep., 104.
Drury vs. Ewing, 1 Bond, 549.

The statute relating to copyrights is founded on the constitutional provision which confers on Congress the power to promote the progress of science and useful arts by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries.

A label is a composition of words and is the product of intellectual labor. The author of the label is required to exercise literary taste and judgment in selecting and combining the words to compose the phrase or title for the label.

A label is an intellectual conception embodying novelty, invention, originality and utility. Its author must exercise intellectual powers and literary taste in composing the label, or in selecting and combining the descriptive words which composed the title of the label. If the Constitution is broad enough to cover a statute authorizing a copyright of photographs, catalogues and pamphlets of every description, it is certainly broad enough to authorize the copyright of labels.

Lithographic Co. vs. Sarony, 111 U. S., 58.

IV.

Is the use of the appellees' label an infringement of the registered label of appellants?

It is not necessary to devote much time to this branch of the case, because the appellees have copied the whole of the appellant's registered label. The only difference between the two labels, so far as phraseology is concerned, is that the appellees have added the word "black," which is a comparatively unimportant and non-distinguishing word in the combination composing the title of the label. The ink of each party is black, and is known to be black ink. The words are arranged on the appellee's label in such a manner that the words "Waterproof Drawing Ink" are conspicuously displayed, and indicate that they constitute the title of the label, and that the word "black" merely indicates the color of the ink (Record, p. 54).

The fact that the appellees regarded the words "Waterproof Drawing Ink" as essentially the title of their label is established by their catalogue, where they quote the liquid drawing ink under the title and by the name of "Waterproof Drawing Ink" and not as "Waterproof Black Drawing Ink" (Record, p. 56).

They cannot escape the charge of infringement on the ground that their label differs from the label of the appellants in its appearance and color, or on the ground that they have added an unimportant word to the title of the label of appellants.

To constitute a piracy of copyright, it is only necessary to show that the original work has been either substantially copied, or has been soimitated as to be a mere evasion of the copyright.

Emerson vs. Davies, 3 Story, 768.
Drury vs. Ewing, 1 Bond, 549.
Brightley vs. Littleton, 37 Fed. Rep., 104.

Copying is not confined to literal repetition, but includes also the various modes in which the matter of any publication may be adopted, imitated or transferred, with more or less colorable alterations to disguise the piracy. An examination of the appellees'

label must lead to the irresistible conclusion that they have inserted the word "black" to disguise the piracy. It will be observed that the appellees have carefully refrained from putting their names upon their label or in any way indicating that the ink is not that of the appellants, and thus are able to deceive the public and derive the benefit of the reputation established by the appellants under the name or label "Waterproof Drawing Ink." Before the appellees began to use this label of appellants, they sold the appellants' ink and quoted it in their catalogues as appellants' ink (Record, pp. 20 and 55). But as soon as they began to sell their own ink with the appellants' label unlawfully connected therewith, they catalogued the ink as "Waterproof Drawing Ink" without indicating that it was not the ink made by appellants (Record, pp. 20 and 56). These facts are sufficient to prove that the appellees deliberately adopted and used the registered label of appellants to obtain the advantage and benefit of the valuable reputation which had been established by appellants under and by their registered label.

The fact that the label of appellees differs in appearance and color from the registered label of appellants is immaterial and unimportant in this case, because this is not an action for an infringement upon a trademark. The appellants might have an adequate remedy under the common law to prevent the imitation of the appearance and color of their label if there had been any infringement thereof by the appellees, but in such a case it would have involved the law relating to trademarks and not the law relating to copyrights.

The case before the Court is an action for the infringement of a copyright or registered label, and in order to determine the question of infringement it is only necessary to determine whether or not the title of the registered label has been used by the appellees. It is the title of the label which is registered in the Patent

Office and which constitutes the label, and that title is the combination of these words, "Waterproof Drawing Ink," and that has been unlawfully appropriated and used by the appellees.

In conclusion, it is respectfully submitted that upon the whole case, as presented in the record, the decree of the Court below was erroneous and should be reversed.

WILLIAM A. REDDING,
Counsel for Appellants.

Extracts from Proceedings in Senate upon the Bill which became the Act of June 18, 1874.

Mr. BOUTWELL. I should like to inquire of the Senator from New Hampshire what the effect of this law will be upon the editions of works already published and which may not be sold until after this act takes effect, and may never again be published by the proprietor.

Mr. WADLEIGH. I will explain in a word the provisions of this bill. I will say, to begin with, that it is reported by the committee, at the request of the Librarian of Congress, to obviate some very serious inconveniences affecting the mode in which business has been done in his office.

The first section simply provides that instead of putting upon works copyrighted "Entered according to Act of Congress in the year —— by A. B. in the office of the Librarian of Congress at Washington" the words "Copyrighted 18— by A. B." may be used. That is to obviate the objection made by parties who procure copyrights for small photographs, that the quantity of print which they are obliged to put upon them operates to deface them, and they desire that there may be some provision so that the words to be printed upon the photograph or picture copyrighted may be less in number.

The second section provides that for recording instruments in the Librarian's office there shall be paid one dollar for each instrument so recorded instead of fifteen cents for every hundred words, to obviate the necessity of counting the words in the instruments which are there copied. To this, of course, there can be no objection.

The third section provides that labels of this kind, which I show to the Senate (exhibiting a label), printed by printers and sold to the trade, which are not trade-

marks, shall be sent to the Patent Office and there recorded instead of being sent to the Library of Congress, they having nothing to do with works of art and having no place for them in the Library of Congress.

That is all there is of the bill. The Librarian is very anxious that it should pass at this session, as he has experienced much inconvenience from the present condition of things.

Congressional Record, 43d Congress, 1st Session.
June 1, 1874, vol. 2, part 5, p. 4413.

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Congressional Record, 43d Congress, 1st Session.
June 1, 1874, vol. 2, part 5, p. 4413.

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SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1890.

No. 290.

CHARLES M. HIGGINS AND JOHN GIANELLA,
Appellants,

vs.

WILLIAM D. KEUFFEL AND HERMAN ESSER,
Appellees.

BRIEF ON BEHALF OF APPELLEES.

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BRIEF ON BEHALF OF APPELLEES.

Statement of Facts.

The complainants below, constituting the firm of Charles M. Higgins & Co., manufacturers of drawing inks, brought suit against the firm of Keuffel & Esser to restrain the latter from selling ink labelled "Waterproof Drawing Ink" on the ground that this was a violation of a right secured by registration in the United States Patent Office pursuant to Chap. 301, approved June 18, 1874, entitled "An Act to amend

the law relating to patents, trade-marks and copyrights," § 3 of which read as follows:

"That in the construction of this act, the words 'engraving,' 'cut' and 'print' shall be applied only to pictorial illustrations or works connected with the fine arts.

"And no prints or labels designed to be used for any other article of manufacture shall be *entered under the copyright law*, but may be registered in the Patent Office. And the Commissioner of Patents is hereby charged with the supervision and control of the entry or registry of such prints or labels, in conformity with the regulations provided by law as to copyrights of prints, except that there shall be paid for recording the title of any print or label, not a trade-mark, six dollars, which shall cover the expense of furnishing a copy of the record under the seal of the Commissioner of Patents to the party entering the same."

All the appellants and appellees are citizens of the State of New York (fols. 3 and 6, Record).

No diversity of citizenship is alleged or proved. No amount in dispute is alleged.

§ 4970, U. S. Rev. Stat., gives the Circuit Court jurisdiction over copyright suits; otherwise we must look to § 1 of Chap. 137, approved March 3, 1875 (Judiciary Act).

Under the act last referred to, the Circuit Court could only have had jurisdiction in case the sum in dispute exceeded five hundred dollars.

There are no decisions construing the act regulating registrations of labels, except that in Marsh vs. Warren, 14 Blatchf., 264, upon a motion for preliminary injunction it was assumed that the section under consideration was part of the copyright law.

This brings us to a consideration of the points involved, which we shall treat under the following heads.

ARGUMENT.

I.

The Constitution of the United States does not give Congress any authority to pass legislation concerning labels.

§ 8 says: Congress shall have power, &c.

"To regulate commerce with foreign nations and among the several States and with the Indian tribes.

"To promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries."

The right of Congress to legislate upon this subject must be found in either of the above clauses.

We believe that the cases known as Trade-mark Cases, 100 U. S., 82, are decisive upon this point.

With regard to the clause conferring the power to regulate commerce, the Court holds that this is limited to commerce with foreign nations, commerce among the States and commerce with the Indian tribes.

The act concerning label registration is not so limited, and would therefore be unconstitutional were it claimed that Congress enacted this act by virtue of the power conferred by that clause of the Constitution.

With regard to the clause concerning writings and discoveries the Court says:

"And while *the word writings may be liberally construed*, as it has been, to include original designs for engravings, prints, etc., *it is only such as are original, and are founded in the creative powers of the mind.* The writings which are to be protected are the fruits of intellectual labor, embodied in the form of books, prints, engravings, and the like."

See also Lithographic Co. vs. Sarony, 111 U. S., 53.

The act on its very face seeks to regulate the registration of illustrations or works not connected with the fine arts and not such as are original and "founded in the creative powers of the mind." The act is therefore unconstitutional.

The argument of counsel for appellants is that Congress intended that the registration of labels in the Patent Office should, as before, remain a part of the copyright system or law.

It is, however, fair to assume that Congress recognized that the Constitution did not permit the copyrighting of commercial labels, and for that reason provided a place for registering the same.

Sections one and two of the act legislate as to copyrights and nothing else. Section three says, substantially, that no prints or labels designed to be used for any other article of manufacture shall be entered under the copyright law; in other words, they shall no longer be copyrightable.

Appellants' counsel argues that the words no prints, &c., "shall be entered under the copyright law," means, "shall be entered in the office of the Librarian of Congress." As the words "but may be registered in the Patent Office" clearly indicate a place and would have most naturally stood in juxtaposition to the words "office of the Librarian of Congress," it is difficult to see why Congress should not have used these words, if that is what it meant, instead of the words "under the copyright law," which words do not indicate a place but rather a condition or state.

The words that the Commissioner of Patents is "charged with the supervision and control of the entry or registry of such prints or labels in conformity with the regulations provided by law as to copyright of prints" indicates or outlines a method of procedure and does not again bring labels under the copyright law, which by a preceding sentence were stricken therefrom. The words have reference to § 4957 and

4959 Revised Statutes, as to the recording of copyright titles in books, the giving of receipts and the receiving of copies. Moreover, this phraseology is quite usual, and at the end of the Trade-mark law as it stood at the passage of this act in § 4947 Revised Statutes, we find the following: "The Commissioner of Patents is authorized to make rules, regulations and prescribe forms for the transfer of the right to the use of a trade-mark, conforming as nearly as practicable to the requirements of law respecting the transfer and transmissions of copyrights."

There can be but one conclusion and that is that Congress did not intend that copyright protection should thereafter be accorded to commercial labels, for it would not be promoting the progress of science and the useful arts.

Counsel for appellants, it seems to us, assumes erroneously that the term label as used in the act is necessarily a combination of descriptive words. It will be noticed that Section 3 begins with the words, "engraving," "cut" and "print," and thereafter uses the words prints or labels as synonymous terms, which they are when attached to articles of merchandise. For instance, a label containing the words, "This box contains boots and shoes," is no less a label, if in place of the words "boots and shoes" there is an illustration of boots and shoes inserted.

We are aware that the Patent Office would refuse to register a label containing an illustration such as above referred to, but we do not consider the definitions of the Patent Office upon this subject authority entitled to much if any weight.

Again, we take issue with appellant's counsel, in defining a label as a verbal composition or phraseology involving literary construction or judgment. We contend that a commercial label ordinarily involves no literary skill or judgment whatever.

A piece of paper containing the words "This pack-

age contains a paper of steel pens" is registerable as a label in the Patent Office, under the act under consideration.

It seems to us that Congress did not intend that § 3 should remain part of the copyright law, but whether it did or not, it certainly is not constitutional that this label registration should be protected by the copyright law.

A label, as defined in the dictionary and as limited in connection with the words of the act, "designed to be used for any other article of manufacture," cannot be such a writing or discovery which Congress would be justified in protecting for limited times. It is not such a writing or discovery as to which the term "author or inventor," can justifiably be used and requires a stretch of the imagination to assume that by protecting labels designed to be used for articles of merchandise, the progress of science and the arts would be promoted.

Moreover, labels used upon articles of merchandise are best protected under the common law applicable to them, or to what is in most cases substantially the same thing, trademarks.

II.

This particular label, registered under the title "Waterproof Drawing Ink," cannot be copyrighted.

On its very face—and there is no evidence or proof to change this—it does not involve originality, intellectual production, thought, conception or creative ability.

Lithographic Co. vs. Sarony, 111 U. S., 60.

In Clayton vs. Stone, 2 Paine, 383, it was said that the copyright act was for the encouragement of learning, and was not intended for the encouragement of mere industry unconnected with learning and the sciences. A newspaper or price current is not such a publication as falls under the protection of the copyright law.

An ordinary descriptive label upon an ink bottle cannot and ought not fall under the protection of the copyright law.

In our opinion it is absurd to claim that it required any intellectual labor to originate the words "waterproof drawing ink." It is conceivable that a copyright would lie for phrases like "*ars longa, vita brevis*" or "honesty is the best policy," &c., and in phrases tersely expressing some axiom or truth, and while there are decisions like the celluloid case, which uphold arbitrary, fanciful and newly-coined words though descriptive of a well-known thing, as good trade-marks, yet it can hardly be claimed that words in ordinary use, so completely suggestive, if not descriptive, as "waterproof drawing ink," are entitled to protection as inventions or concrete evidences of creative ability.

In accordance with the decision in Lithographic Co. vs. Sarony, 111 U. S., 60, the burden of proof was upon complainants to show the intellectual labor and creative ability required in the production of this label. There is no proof upon this subject, unless it be argument of appellants' counsel.

III.

This suit cannot be maintained, because of a failure to comply with the copyright law.

Complainants have failed to mark their label "Copyright 1883, by Chas. Higgins," or "Entered according to Act of Congress in the year 1883 by Charles Higgins in the office of the Librarian of Congress or in the Patent Office," as required by § 1, Chap. 301, approved June 18, 1874, which begins as follows: "That no person shall maintain an action for the infringement of his copyright unless he shall give notice thereof, by inserting," &c., the words above referred to.

In Lithographic Co. vs. Sarony, 111 U. S., 55, the Court says:

"The object of the statute is to give notice of the copyright to the public by placing upon each copy in some visible shape the name of the author, the existence of the claim of exclusive right and the date at which this right was obtained."

If the label registration is a part of the copyright law, it needs no further argument to show that the words "Registered, 3693, 1883," do not comply with the letter or spirit of the law.

Upon this subject we quote from the decision of the Court below:

"No remedy for infringement is given by that act; but the form of the notice, without which no action could be maintained, is so varied that it may be by the word 'copyright,' with the year in which, and the person by whom, the copyright was taken out, instead of a statement of an entry in the office of the Librarian, as before was required. This would enable a notice of a copyright by registration to be given without the making of a false statement as to entry, and make the statutes harmonious."

Counsel for appellants argues that all the sections of the copyright law apply to the label registration only not the one requiring a copyright notice to be given; he further argues that this provision, taking away the right to maintain suit, is of a penal nature and must be strictly construed. Assuming this to be so, there is

this to be said upon the other side, that § 4965 Revised Statute is of a highly penal nature and would have punished defendants for violating the copyright law, by the confiscation of plates and labels and the forfeiture of one dollar for every label found in their possession, and therefore the section depriving the complainants of their right to sue must be strictly construed in view of § 4965, by accepting Judge WHEELER's views the statutes are made harmonious.

IV.

The Circuit Court had no jurisdiction.

If the label registration is not part of the copyright law, then the Court below had no jurisdiction, because the pleadings show all the parties to have been citizens of the State of New York, and no amount in dispute is either alleged in the pleadings or proven.

§ 1 of Chap. 137, approved March 3, 1875 (Judiciary Act).

V.

Complainant's and defendant's labels are totally dissimilar.

Even if this label was properly copyrighted it is not infringed by defendant's label. A simple comparison of the two will show this. As we understand the copyright law, it means to protect the general arrangement

or design in case of a cut or print. Thus, if a person copyrighted a print or engraving representing a lake with a ship upon the same, every other picture of a lake with a different ship upon the same, the *tout ensemble* of which would leave a different impression upon the eye or mind, would not be an infringement of the first, even if it was copyrighted.

This case of plaintiff's label consists of the words "Waterproof Drawing Ink," large black letters upon a white background, enclosed by black lines, the whole forming a parallelogram. The defendants print the word "waterproof" in black upon a white background over the word black in white upon a red background, with the words "drawing ink" in black upon a white background underneath the same, and two medallions on each side of the label; the whole enclosed by one red line and two black lines, totally different in appearance from complainants' label.

The words are concededly descriptive of the ink.

They are not even arbitrary and fanciful. It is absurd to suppose that any kind of protection can pre-empt descriptive words in the language under any kind of law. If this was permitted the whole language could be pre-empted similarly in a short time. To say the least, this would be against public policy.

VI.

Additional obscurity of the law.

Aside from the points above discussed, we beg to call the Court's attention to the following additional and unfortunate state of affairs with regard to this rather obscure law. A lithographer to-day designs an original picture requiring creative ability. The litho-

graph is from its size, and because it has medallions or words on its face, evidently intended to be used for other articles of merchandise. The lithographer intends to keep it in stock and sell it to different persons. If he attempts to enter it in the office of the Librarian of Congress, it is refused because of the section under consideration, the Librarian adjudging such lithographs to be labels intended for use upon some other article of merchandise. If he attempts to enter it in the Patent Office the Commissioner of Patents refuses to register it as a label because it contains some arbitrary word or symbol, and according to his contention is a trade-mark.

It cannot be entered as a trade-mark because the lithographer cannot get a valid trade-mark in the article itself which he sells.

An appeal from the Commissioner's or Librarian's decision is not possible, and in consequence registration to the more valuable labels, those which are ornamental and upon which originality and intellectual labor have been expended are denied, while labels devoid of any intellectual labor like the one in suit are registered.

Conclusion.

The appeal ought to be dismissed and the decree of the Circuit Court affirmed.

Respectfully submitted.

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